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Supreme Court, U.S.
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No. 07-

IN THE

Supreme Court of the United States

ROSENRUIST-GESTAO E SERVICOS LDA, FORMERLY KNOWN AS ROSENRUIST-GESTAO E SERVICOS SOCIEDADE UNIPESSOAL LDA,

Petitioner,

v.

VIRGIN ENTERPRISES LIMITED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

35 U.S.C. § 24 permits a district court to assist the United States Patent and Trademark Office ("PTO") in a contested case by issuing testimonial subpoenas to a witness "residing or being within such district." The First, Third, and Fifth Circuit Courts have held that the authority granted in Section 24 is ancillary and limited and is to be used to compel discovery allowed by the rules and procedures of the PTO. The Tenth Circuit has disagreed, holding that Section 24 authorizes broad discovery independent of any limitation in the PTO's procedures.

In the instant appeal a divided Fourth Circuit held, for the first time, that a foreign applicant for a trademark which lacks any nexus to the district other than the filing of a trademark application based upon a future intent to use the mark is a "witness residing or being within" the Eastern District of Virginia and can be compelled by subpoena issued pursuant to Section 24 to transport witnesses from abroad to be deposed in the district. The rules and procedures of the PTO do not permit in-person testimonial depositions of foreign witnesses, but do provide alternate methods for obtaining such testimony.

The questions presented are:

1. Does 35 U.S.C. § 24 authorize a district court to subpoena foreign witnesses with no contact with the United States other than the filing of a trademark application to appear personally for deposition in Virginia when the rules and procedures of the United

States Patent and Trademark Office do not authorize such depositions but, instead, permit alternate means for obtaining testimony?

2. Is a foreign company with no employees, locations or other business in the United States a "witness residing or being" within the Eastern District of Virginia under 35 U.S.C. § 24 solely because it filed a trademark application with the United States Patent and Trademark Office?

PARTIES TO THE PROCEEDING AND RULE 29.6 STATEMENT

The caption contains the names of all the parties to the proceeding below.

Petitioner, Rosenruist-Gestao E Servicos LDA, has no parent company, and no publicly held company owns 10% or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Rosenruist-Gestao E Servicos LDA respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Fourth Circuit.

OPINIONS BELOW

The court of appeals' opinion is reported at 511 F.3d 437. App., *infra*, at A. The order of the district court denying respondent's objections to the magistrate judge's order regarding respondent's motion to compel was entered by the district court on May 2, 2006 and is electronically available through the CM/ECF system for the District Court for the Eastern District of Virginia as docket entry No. 52. App., *infra*, at D. The Magistrate Judge's rulings regarding respondent's motion to compel were made from the bench during a hearing conducted April 7, 2006, as noted in an order dated April 7, 2006 and entered in the district court on April 10, 2006 as docket entry No. 33. The magistrate judge's order as well as the transcript of the April 7, 2006 hearing are not available electronically. However, the order and relevant portions of the transcript are included in the attached Appendix. App., *infra*, at E and F.

JURISDICTION

The district court had jurisdiction over the respondent's claims pursuant to 28 U.S.C. §§ 1331 and 1338(a). The court of appeals had jurisdiction over the district court's final judgment pursuant to 28 U.S.C. § 1294(1). The court of appeals filed its opinion on

December 27, 2007. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Title 35 U.S.C. § 24 provides:

> The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.
>
> Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.
>
> A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty

of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

Title 28 U.S.C. § 1783 provides:

(a) A court of the United States may order the issuance of a subpoena requiring the appearance as a witness before it, or before a person or body designated by it, of a national or resident of the United States who is in a foreign country, or requiring the production of a specified document or other thing by him, if the court finds that particular testimony or the production of the document or other thing by him is necessary in the interest of justice, and, in other than a criminal action or proceeding, if the court finds, in addition, that it is not possible to obtain his testimony in admissible form without his personal appearance or to obtain the production of the document or other thing in any other manner.

(b) The subpoena shall designate the time and place for the appearance or for the production of the document or other thing. Service of the subpoena and any

> order to show cause, rule, judgment, or decree authorized by this section or by section 1784 of this title shall be effected in accordance with the provisions of the Federal Rules of Civil Procedure relating to service of process on a person in a foreign country. The person serving the subpoena shall tender to the person to whom the subpoena is addressed his estimated necessary travel and attendance expenses, the amount of which shall be determined by the court and stated in the order directing the issuance of the subpoena.

STATEMENT OF THE CASE

Rosenruist-Gestao E Servicos LDA ("Rosenruist") is a Portuguese Corporation that conducts no business of any nature in the United States. In December 2002 Rosenruist filed a U.S. trademark application for registration of the trademark VIRGIN GORDA in International Trademark Class 18 for bags and Class 25 for clothing. As permitted by 15 U.S.C. § 1051, the application was based upon Rosenruist's future intent to sell the trademarked products in the United States.

Virgin Enterprises Limited ("VEL"), the parent company of Virgin Atlantic Airways, Ltd., filed an opposition to Rosenruist's application asserting that Rosenruist's application for a VIRGIN GORDA mark for a line of bags, purses, clothing, and footwear would confuse customers of VEL and its affiliates. After the conclusion of the discovery period set by the Trademark

Trial and Appeal Board ("TTAB"), VEL filed a motion to take the testimonial deposition of Rosenruist in Portugal. The TTAB denied the motion, pointing out that TTAB procedures do not provide for such depositions. App., *infra*, at G. The Board referred VEL to the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), which identifies alternate means of discovery available to secure the testimony of a foreign applicant. *Id.*; *see also* TBMP § 703.01(a), (b), and (f)(1)-(3) (2d ed. rev. 2004).

VEL did not attempt to utilize any of the methods specified by the TTAB. Instead, under the averred authority of 35 U.S.C. § 24, it served a subpoena on an attorney in the Eastern District of Virginia whose firm was listed as Rosenruist's agent for the service of process for the purposes of the trademark application. The subpoena directed Rosenruist to produce witnesses in the Eastern District to testify on Rosenruist's behalf on designated subjects.

Rosenruist moved in the district court for the Eastern District of Virginia to quash the subpoena. The district court held that the subpoena was "facially valid" and denied the motion. App, *infra*, at C. The district court did not specifically address the requirements of the "witness residing or being" language in 35 U.S.C. § 24, but, consciously echoing that language, ordered Rosenruist to produce a witness "residing or being" within the district to be deposed. *Id.* Rosenruist's attorney appeared at the deposition to state that Rosenruist had no such witnesses and VEL then filed a motion to compel.

The district court[1] held that notwithstanding its prior ruling regarding the "facial" validity of the subpoena, the subpoena could not be enforced since it did not meet the "witness residing or being" requirements of Section 24. App., *infra*, at D, E, and F.

VEL appealed to the United States Court of Appeals for the Fourth Circuit. In a divided opinion the majority ruled that the subpoena was valid, and that Rosenruist would be compelled to transport witnesses to the Eastern District of Virginia to be deposed. App., *infra*, at A; *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Limited*, 511 F.3d 437, 448 (4th Cir. 2007).

In dissent, Judge Wilkinson concluded that the majority misapplied the "witness residing or being within" requirement of 35 U.S.C. § 24. *Id.* at 449. Based on the text of the statute, established interpretive canons, international relationships, separation of powers concerns, and deference to the PTO's own framework, Judge Wilkinson stated,

> There is thus no question that 35 U.S.C. § 24 does not permit this subpoena to be enforced. The majority - in enforcing the subpoena and in concluding flatly that "Rosenruist's activities in this case were sufficient to qualify it as 'being within [the] district' " – manages astonishingly to say that

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[1] The rulings on the motion to quash and motion to compel were made by a United States Magistrate Judge and subsequently were upheld by a United States District Court Judge. App. *infra* at B and D.

> the issue of the subpoena's enforcement pursuant to 35 U.S.C. § 24 is somehow not before the court. This is too clever by half. The district court's ultimate judgment was that Rosenruist could not be compelled to give an in-person deposition because the conditions of 35 U.S.C. § 24 had not been met. The majority, however, discusses who may be a "witness" under 35 U.S.C. § 24 and then re-labels the "residing or being" requirement of § 24 as a question bearing upon the "validity" of the subpoena, as though that will somehow make the statute go away. But courts cannot interpret one word in a prepositional phrase and ignore another. By picking only selective portions of § 24 to interpret, the majority manages to enforce the subpoena, in violation of the explicit standard Congress has given us to apply.

Id. at 452 (internal citations removed).

REASONS FOR GRANTING THE PETITION

For the first time, a United States court has ruled that a foreign company with no ties to the United States other than the filing of a trademark application may be required by 35 U.S.C. § 24 to produce witnesses for deposition in the Eastern District of Virginia. This ruling misconstrues the plain language of the statute, which applies only to witnesses "residing or being within" the district.

The effect of this over-extension of the statute is inconsistent with established principles of comity and statutory construction, *Hoffmann-La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155, 156 (2004), *Blackmer v. United States*, 284 U.S. 421 (1932), and will have the highly probable effect of subjecting U.S. companies to similar demands that they produce witnesses in numerous foreign locations merely because they filed an application for a trademark or a patent.

The ruling disregards that 35 U.S.C. § 24 was enacted to assist the PTO in enforcing its own rules, and was not intended to grant the district courts original power to order depositions or document productions independently of the PTO's rules and procedures. With respect to foreign witnesses, the PTO has long-standing procedures to obtain relevant information and has expressed no dissatisfaction with its ability under these procedures to obtain evidence necessary for its decision making process. Neither the language of the statute nor the interpretation of "residing or being" utilized by the PTO itself remotely suggests that a statute whose sole purpose is to assist the PTO should be used to confer expansive new powers which risk retributive action by other countries.

There is a split among the circuit courts regarding the scope and interpretation of Section 24. The First, Third, and Fifth Circuits construe Section 24 as ancillary authority to obtain testimony or documents available under the PTO's rules. The Tenth Circuit, and now the Fourth Circuit, construe Section 24 to permit independent discovery proceedings under the Federal Rules of Civil Procedure.

The dissent in the Fourth Circuit and the decision of the First Circuit Court of Appeals in *Sheehan v. Doyle* have noted the different interpretations of Section 24 by the circuits as well as the discord with principles of comity and accepted norms of international law presented by the attempted use of Section 24 to compel foreign trademark and patent applicants to appear in the United States. *Rosenruist* at 453-54 and 460; *Sheehan*, 529 F.2d 38, 39 (1st Cir. 1976). They have suggested that the conflicting application of 35 U.S.C. § 24 among the circuits deserves the attention of this Court. *Id.*

I. The Majority's View Of 35 U.S.C. § 24 Conflicts With The Prevailing Construction By Other Circuits

The First, Third, and Fifth Circuits have held that Section 24 authorizes district courts to issue subpoenas for evidence only when the PTO's rules and procedures also authorized the parties to obtain the evidence in question. *Brown v. Braddick*, 595 F.2d 961, 966 (5th Cir. 1979); *Sheehan v. Doyle*, 529 F.2d 38, 39 (1st Cir. 1976) ("Doyle II"); *Sheehan v. Doyle*, 513 F.2d 895 (1st Cir. 1975) ("Doyle I"); *Frilette v. Kimberlin*, 508 F.2d 205 (3rd Cir. 1974) (en banc). Under the holdings of these circuits, PTO litigants cannot obtain discovery under Section 24 that exceeds the scope of discovery contemplated by the PTO's own procedures. The rules and procedures of the PTO do not authorize depositions of non-resident foreign applicants in Virginia. Instead, the PTO rules affirmatively propose alternate methods of discovery in recognition that foreign witnesses may not be compelled to journey to the United States. *See* 37 C.F.R. §§ 2.123(2) and 2.124; TBMP § 703.01(f)(3).

In conflict with these circuit court rulings, the Tenth Circuit has held that the full scope of discovery available under the Federal Rules of Civil Procedure is available under Section 24 to a party to a contested proceeding at the PTO. *Natta v. Hogan*, 392 F.2d 686, 690 (10th Cir. 1968). The discovery said to be available is not inhibited by the PTO's own rules and views.

Accordingly, there is a split among the circuit on the scope and limitations of Section 24. This split applies directly to the present holding that Section 24 may be used to compel attendance in Virginia of foreign witnesses even though the PTO's own rules and procedures do not authorize such discovery but provide alternate means for obtaining testimony from foreign witnesses which do not transact business in the United States.

As noted in the *Doyle II* opinion, "[t]he Supreme Court may think it desirable to terminate the divergent interpretations that now exist." 529 F.2d at 39.

II. By Its Express Terms 35 U.S.C. § 24 Limits the Subpoenaed Person Or Entity To A "Witness Being or Residing in [the] District"

35 U.S.C. § 24 authorizes a court to issue a subpoena commanding "any witness residing or being within" its district to appear. The statute does not extend to all potential witnesses in a contested case in the PTO; rather it is qualified by the words "residing or being within." These words are a limitation on the word "witness" and the statute may not be parsed to ignore them.

The phrase "residing or being within" has not been the subject of prior judicial construction. *Rosenruist* at 450, n.1. In the context of 35 U.S.C. § 24, there are numerous reasons to construe "residing or being" as not covering Rosenruist.

Rosenruist has no employees or facilities in the Untied States, and no contact with the United States other than its intent-to-use application for registration of VIRGIN GORDA, and cannot be said to be "residing" or "being" within the district under any ordinary meaning of these terms. Accordingly, the plain language of the statute appears to preclude its application to Rosenruist.

In addition, rules of construction emphasized repeatedly by this Court require that judges "ordinarily construe[ ] ambiguous statutes to avoid unreasonable interference with the sovereign authority of other nations" and to assume that "that legislators take account of the legitimate sovereign interests of other nations when they write American laws." *Hoffmann-La Roche Ltd.*, 542 U.S. at 156.

Expanding "residing or being within" to foreign entities lacking nexus to the district also is inconsistent with TTAB's own interpretation of "residing or being within." The TTAB's manual of procedure states that a district in which a domestic witness is "residing" or "being" is a district "where the witness resides or is regularly employed." TBMP § 703.01(f)(2). It would violate principles of comity and fairness to impose a different and discriminatory standard on foreign PTO applicants.

Neither does Rosenruist's designation of an agent for process of service imply that Rosenruist is present within the district. Courts of appeals have consistently refused to find that a registered agent for service of process is sufficient to establish jurisdiction over a corporation. *Consolidated Development Corp. v. Sherritt, Inc.*, 216 F.3d 1286, 1293 (11th Cir. 2000); *Wenche Siemer v. Learjet Acquisition Corp.*, 966 F.2d 179, 183 (5th Cir. 1992); *Ratliff v. Cooper Laboratories, Inc.*, 444 F.2d 745, 748 (4th Cir. 1971). Both the majority and the dissent in the opinion below appear to agree with these holdings. *Rosenruist* at 446 and 451.

Similarly, the mere prosecution of an intent-to-use application associated with the designation, without more, cannot constitute presence within the district sufficient for the "residing or being" requirement of Section 24. To anchor the jurisdictional basis for a subpoena requiring foreign witnesses to travel to and appear in the district on such a minimal contact would not comport with due process principles repeatedly enunciated by this Court.

III. The Majority Decision Inexorably Intrudes Upon the Interest of Other Nations

The majority opinion of the Fourth Circuit effectively creates a national standard under which citizens of other nations will be compelled to travel to the United States to give deposition testimony if a trademark application is contested. This standard conflicts with this Court's views regarding the law of foreign relations and the

application of statutes with foreign implications. As reasoned in the dissenting opinion:

> It hardly respects the legitimate interests of other nations, *see Hoffmann-La Roche*, 542 U.S. at 164, 124 S.Ct. 2359, to allow litigants to compel in-person testimony in the Eastern District from representatives of foreign companies whose only act within our borders has been the filing of a trademark application. In giving regard to other nations' interests, the Supreme Court has held that judges "must assume" Congress ordinarily seeks to follow the Restatement of Foreign Relations Law in determining whether a U.S. statute applies. *Id.* at 164, 124 S.Ct. 2359. The Restatement provides that a nation will not exercise its jurisdiction "when the exercise of such jurisdiction is unreasonable," Rest. (Third) Foreign Rels. Law § 403(1) (2006), and that a foreign person or company's "connections, such as nationality, residence, or economic activity" to the state are one relevant consideration, *id.* § 403(2)(b). To make the price of a simple trademark application an overseas trip by a company officer or officers to answer a deposition is to impose a substantial burden from a minimal connection.

Rosenruist at 454. The majority decision ignores the effect upon comity and commerce among nations and indisputably is at odds with the requirement that a nation's jurisdiction may not be exercised when it would be unreasonable to do so.

The majority opinion also to conflicts with the spirit and intent of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol, to which the United States is a party, provides a mechanism through which an applicant can obtain registration of trademarks through a single unified filing designating the various countries in which protection is being sought. To be sure, the Protocol does permit a national trademark office in a country where recognition is sought to refuse protection on the same grounds which would apply to an application made directly to that office, but it seems apparent that the necessity of personal testimonial appearances in many countries where protection is sought would defeat the very purpose of the Protocol.

As noted in the dissenting opinion, "The majority's disregard of these cautionary canons of construction invites retaliation actions of all sorts." *Rosenruist* at 456. Construing "residing or being within" a district to embrace foreign trademark applicants with no other presence within the United States would be disruptive of the functioning of the trademark system throughout the world. The probable harmful effect upon U.S. citizens and companies further reinforces the wisdom of confining 35 U.S.C. 24 to its plain language.

IV. Non-Resident Aliens Ordinarily Are Not Subject To The Subpoena Power Of A U.S. Court

A principle of international law recognized by courts in the United States is that non-resident aliens may not be compelled to appear in a foreign country to give deposition testimony. This principle was recognized by

the Court as early as *Blackmer v. United States*, 284 U.S. 421 (1932), and finds reinforcement in subsequently enacted versions of 28 U.S.C. § 1783. This statute authorizes U.S. courts, upon a demonstration of "particular" need "in the interest of justice," to compel the testimony of a *U.S.* citizen located abroad. 28 U.S.C. § 1783.

The *Blackmer* decision emphasized the distinction for subpoena purposes between a U.S. citizen residing abroad and a non-U.S. citizen residing in the same country. Blackmer was a U.S. citizen who refused to appear as a witness on behalf of the United States at a criminal trial in the District of Columbia. A unanimous Court held that, because he was a United States citizen, Mr. Blackmer was subject to the subpoena power of the United States courts. However, the Court explained that it was because he was a U.S. citizen that a U.S. court had the power to subpoena him from his residence in a foreign nation. *Blackmer* at 436-38.

> With respect to such an exercise of authority [subpoena of a U.S. citizen], there is no question of international law, but solely of the purport of the municipal law which establishes the duties of the citizen in relation to his own government. *While the legislation of the Congress, unless the contrary intent appears, is construed to apply only within the territorial jurisdiction of the United States,* the question of its application, so far as citizens of the United States in foreign countries are

> concerned, is one of construction, not of legislative power.

Id. at 437 (emphasis added).

The Supreme Court's decision in *Blackmer* confirmed the ability of a U.S. court to subpoena U.S. citizens residing abroad in criminal cases. Congress subsequently extended this subpoena power to apply in non-criminal cases by amending Section 1783. However, the amendments imposed significant limitations on the assertion of the subpoena power over non-resident U.S. citizens in civil actions. As noted in the legislative history of the 1964 amendments:

> A subpena [sic] to be served abroad in other than criminal proceedings may be issued *only* if the court finds that its issuance is in the interest of justice, and *in addition*, that the testimony or evidence sought cannot be obtained in another manner. The purpose of the different language used with respect to noncriminal cases is to restrict still further the extraordinary subpena [sic] power in such cases.

S. Rep. No. 88-1580, at 10 (1964), *reprinted in* 1964 U.S.C.C.A.N. 3782, 3790-91 (emphasis added).

VEL cannot meet the test of unavailability of the testimony through other means. The Rules of the PTO specifically contemplate that testimony of a non-resident alien be taken by deposition on written questions. *See* 37 C.F.R. §§ 2.123(a)(2) and 2.124. The PTO's

procedures further specify that a party may seek testimony under either the letters rogatory procedure or pursuant to The Hague Convention letter of requests procedure. TBMP 703.01(f)(3). VEL's attempt to subpoena a non-resident alien to appear in the United States is in clear disregard of both Section 1783 and the rules and procedures of the U.S. Patent and Trademark Office.

CONCLUSION

This petition presents an important issue of apparent first impression as to the meaning of "residing or being with such district" as used in 35 U.S.C. § 24, and it presents a conflict among the circuits as to the intended scope of this statute.

Rosenruist's petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT DECIDED DECEMBER 27, 2007

UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

No. 06-1588

ROSENRUIST-GESTAO E SERVICOS LDA, formerly known as Rosenruist-Gestao E Servicos Sociedade Unipessoal LDA,

Plaintiff-Appellee,

v.

VIRGIN ENTERPRISES LIMITED,

Defendant-Appellant.

Argued: March 16, 2007

Decided: December 27, 2007

Before WILKINSON and TRAXLER, Circuit Judges, and WILKINS, Senior Circuit Judge.

Reversed and remanded by published opinion. Judge Traxler wrote the majority opinion, in which Senior Judge Wilkins joined. Judge Wilkinson wrote a dissenting opinion.

Appendix A

OPINION

TRAXLER, Circuit Judge:

Rosenruist-Gestao E Servicos LDA ("Rosenruist") is a Portuguese company that seeks to obtain a United States trademark registration and enjoy the benefits that accompany ownership of a registered mark under the Lanham Act. Virgin Enterprises Ltd. ("VEL"), a British conglomerate that owns numerous United States registrations, opposes the registration of Rosenruist's mark and commenced an administrative proceeding before the Trademark Trial and Appeal Board ("TTAB") against Rosenruist to prevent the registration. When Rosenruist refused to appear voluntarily for a Rule 30(b)(6) deposition under the procedural rules promulgated by the Patent and Trademark Office ("PTO"), *see* 37 C.F.R. § 2.123 (2006), the district court issued a subpoena under 35 U.S.C.A. § 24 directing Rosenruist to produce a designee to testify on behalf of the corporation at a deposition in Virginia. The district court refused Rosenruist's request to quash the subpoena and then subsequently imposed sanctions against Rosenruist when it failed to attend the deposition.

Seeking to ensure Rosenruist's cooperation, VEL filed a motion to compel Rosenruist, on pain of contempt sanctions, to designate its Rule 30(b)(6) representative and appear for the corporate deposition as directed by the subpoena. Notwithstanding its earlier ruling that Rosenruist had been properly served with a valid

subpoena for a Rule 30(b)(6) deposition, the court determined that it could not require Rosenruist to produce a corporate designee for the deposition unless that designee personally resided within the district of the issuing court. Because there are no individuals residing within the Eastern District of Virginia who Rosenruist could designate as its witness under Rule 30(b)(6), the court denied VEL's request to compel an appearance.

VEL appeals this ruling. For the reasons that follow, we reverse.

I.

Rosenruist filed an application in December 2002 with the PTO to register the mark VIRGIN GORDA under section 1(b) of the Lanham Act. *See* 15 U.S.C.A. § 1051(b) (West Supp.2007). At the time, Rosenruist had not sold any products in the United States or established a business presence here. Section 1(b) of the Act permits an applicant to seek trademark registration based on the applicant's intent to use the trademark in commerce rather than the actual use of the mark, provided that the applicant later files "a verified statement that the mark is in use in commerce." *See* 15 U.S.C.A. § 1051(d)(1) (West Supp.2007).[1]

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1. Although the owner of a mark may *apply* for registration based on his intent to use the mark in the future, the mark is not registrable until it has actually been used in commerce and the applicant has filed a statement verifying such use. *See* 15 U.S.C.A.

(Cont'd)

Rosenruist applied to register based on its intent to use the mark VIRGIN GORDA in connection with forty-one categories of goods, including "[b]ags, purses, . . . traveling bags, trunks, make-up bags and empty vanity cases, document holders, umbrellas, [and] handbags," as well as various kinds of clothing and footwear. J.A. 46. In its application with the PTO, Rosenruist appointed various members of the Virginia-based law firm prosecuting the application as "domestic representatives" under 15 U.S.C.A. § 1051(e) to act as Rosenruist's designees "upon whom notices or process in proceedings affecting this mark may be served." J.A. 52.

Initially, the PTO's examining attorney refused registration on the basis that the VIRGIN GORDA mark is "primarily geographically deceptively misdescriptive," 15 U.S.C.A. § 1052(e)(3) (West Supp.2007), explaining that Virgin Gorda is an island located within the British Virgin Islands and that its proposed use would cause the public to mistakenly believe that Rosenruist's goods bearing this mark came from the Virgin Islands. Ultimately, however, the examining attorney agreed with Rosenruist that there was insufficient basis for believing that the misdescription would be a material factor in the consuming public's purchasing decisions, withdrew the

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(Cont'd)

§§ 1051(b), (d). This requirement reflects the fundamental principle in American trademark law that ownership rights flow from actual use of the mark in commerce. *See Emergency One, Inc. v. American Fire Eagle Engine Co.*, 332 F.3d 264, 267 (4th Cir.2003).

refusal to register, and caused the PTO to publish the mark in its Official Gazette. *See* 15 U.S.C.A. § 1062(a) (West Supp.2007).

In July 2004, VEL filed a Notice of Opposition with the PTO. *See* 15 U.S.C.A. § 1063(a) (West Supp.2007). VEL has a substantial presence in the United States through a vast array of businesses such as Virgin Atlantic Airways, Virgin Records, Virgin Mobile, Virgin Wines, and Virgin Digital. The VEL conglomerate and its related companies sell and distribute a wide variety of goods and services under the registered VIRGIN mark, including clothing, cosmetics, luggage, bags, wallets, umbrellas, records and CDs, telecommunications products, airline and travel-related services, and restaurant and hotel services. VEL asserted that it would be damaged by the proposed VIRGIN GORDA registration because it is confusingly similar to VEL's VIRGIN mark. Under the trademark practice rules adopted by the PTO, VEL conducted limited discovery through written questions, but it did not seek to conduct a discovery deposition prior to the expiration of the discovery period. *See* 37 C.F.R. § 2.120(a).

In December 2005, VEL, pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure, sought to conduct a testimonial deposition of Rosenruist to present in evidence at trial before the TTAB.[2] When Rosenruist

2. We note that the discovery period had expired by the time VEL requested Rosenruist appear for a Rule 30(b)(6) deposition. In opposition proceedings before the TTAB, discovery

(Cont'd)

refused to appear voluntarily in the United States for an oral deposition, VEL moved pursuant to the PTO's rules of procedure to compel Rosenruist to identify a Rule 30(b)(6) representative and produce that person to testify for the corporation at an oral deposition in Portugal. *See* 37 C.F.R. § 2.123(a)(2) (2006). The TTAB denied VEL's motion to compel, noting that, according to its manual of procedure, a party residing in a foreign country may be compelled to appear for an oral testimonial deposition only through the procedures provided in The Hague Convention or the issuance of letters rogatory to the appropriate Portuguese legal authority. *See* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§ 703.01(a), (f)(3) (2d ed.2003).

(Cont'd)

depositions and testimonial depositions for presentation at trial are treated very differently. *Compare* 37 C.F.R. § 1.120 (2006) *with* 37 C.F.R. § 1.123 (2006); *see generally Fischer Gesellschaft M.B.H. v. Molnar & Co.*, 203 U.S.P.Q. 861 (T.T.A.B.1979). A deposition taken pursuant to Rule 30(b)(6) strikes us as a discovery tool, given its general purpose of permitting the examining party to discover the corporation's position via a witness designated by the corporation to testify on its behalf. Nevertheless, we are not faced today with the issue of whether the PTO's rules allow a Rule 30(b)(6) deposition to be taken during the testimony periods set by the TTAB. The magistrate judge below concluded that Rosenruist did not contest VEL's right to seek the Rule 30(b)(6) testimony, and Rosenruist has not challenged that conclusion on appeal. Thus, we assume for purposes of this appeal that the Rule 30(b)(6) deposition sought by VEL is a testimonial deposition like any other under the PTO's procedures.

Appendix A

In January 2006, VEL served Thomas Perkins—one of the lawyers designated by Rosenruist as its representative under § 1051(e)—with a Rule 30(b)(6) deposition subpoena directing the Rosenruist corporation to appear in McLean, Virginia, and produce the "person having [the] most knowledge" regarding, among other topics, "[t]he factual representations made in [Rosenruist's trademark] Application." J.A. 140, 142.

The subpoena was issued by the district court for the Eastern District of Virginia pursuant to 35 U.S.C.A. § 24, which provides in pertinent part:

> The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the [PTO], shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses . . . shall apply to contested cases in the [PTO].

35 U.S.C.A. § 24 (West 2001).

Rosenruist moved pursuant to Rule 45(c)(3)(A) to quash the subpoena, *see* Fed.R.Civ.P. 45(c)(3)(A), arguing that the district court lacked the authority to subpoena

a foreign resident to appear in the United States for a deposition, that VEL was attempting to circumvent the proper procedure for compelling Rosenruist's testimonial deposition as outlined by the TTAB in its order denying VEL's initial motion to compel, and that service of the subpoena on counsel for Rosenruist was ineffective even if the subpoena was valid.

The magistrate judge concluded that the subpoena was properly issued and valid under 35 U.S.C.A. § 24 and rejected Rosenruist's argument that § 24 did not give the district court subpoena power over non-resident foreign corporations. The magistrate judge also concluded that service of the subpoena on counsel for Rosenruist was effective because Rosenruist, in conjunction with its registration application, had designated counsel to accept service of "notices or process in proceedings affecting the mark." 15 U.S.C.A. § 1051(e) (West Supp.2007). Accordingly, on March 2, 2006, the magistrate judge entered an order denying Rosenruist's motion to quash and directing Rosenruist "to designate a Rule 30(b)(6) witness residing or being within this judicial district to appear for deposition by March 15, 2006." J.A. 185. Rosenruist filed objections to the order of the magistrate judge, *see* Fed.R.Civ.P. 72(a), arguing primarily that the district court lacked the authority to issue a subpoena to non-resident aliens. The district court denied Rosenruist's objections, finding that the decision of the magistrate judge was not contrary to law and did not rest on clearly erroneous factual findings. Rosenruist did not appeal the order denying its motion to quash.

Following the court's denial of Rosenruist's motion to quash, VEL re-served the subpoena and rescheduled the deposition. Rosenruist, however, refused to produce a Rule 30(b)(6) designee at the deposition. Instead, counsel for Rosenruist appeared and announced that Rosenruist did not intend to designate a representative to testify on behalf of the corporation as there was no such person "residing or being" within the Eastern District of Virginia. J.A. 259.[3] VEL then sought and obtained sanctions against Rosenruist for its failure to appear at the deposition. The magistrate judge ordered that Rosenruist pay the legal fees and costs incurred by VEL in connection with counsel's preparation for and appearance at the deposition.

On March 31, 2006, in view of Rosenruist's continued belief that it was neither required nor able to comply with the subpoena, VEL moved the district court for an order compelling Rosenruist to obey the subpoena, which the court had already deemed valid, and to produce an appropriate representative under Rule 30(b)(6) to be deposed on the subjects identified in the subpoena. VEL argued that, because a corporation can only testify through its individual representatives, Rosenruist was technically the witness in a Rule 30(b)(6) deposition. And, because Rosenruist had designated a Virginia resident as domestic representative under 15 U.S.C.A. § 1051(e), it was within the judicial district wherein the deposition testimony would be taken. *See* 35 U.S.C.A. § 24. VEL

3. Meanwhile, Rosenruist, through counsel, attended and participated fully in the testimonial depositions of various VEL officers.

asserted that "Rosenruist can no more refuse to attend its own deposition than can any other alien corporate litigant that is subject to the Court's *in personam* jurisdiction." J.A. 345-46.

In response, Rosenruist argued that all of its potential Rule 30(b)(6) designees were foreign citizens residing outside the United States and beyond the reach of the court's subpoena power under 35 U.S.C.A. § 24; that the court did not even have personal jurisdiction over Rosenruist, which had not conducted any business in the country; and that Rosenruist, as a corporation, did not qualify as a witness under 35 U.S.C.A. § 24 because the statute pertains only to subpoenas directed to natural person witnesses.

After hearing VEL's motion to compel, the magistrate judge concluded that, even though Rosenruist had been properly served with a valid subpoena, Rosenruist was not required to produce a Rule 30(b)(6) designee unless that designee resided within the district. The decision of the magistrate judge rested on his conclusion that the term "witness" as used in the statute applied only to natural persons. The court instructed Rosenruist to file a declaration indicating that there was no officer, director, or managing agent of Rosenruist residing in the district who could address the topics listed in the subpoena. Likewise, the court instructed Rosenruist to include in its declaration a statement regarding whether there resided within the district "other persons" who "consent[ed] to testify on its behalf." J.A. 409. Because the magistrate judge did

not compel Rosenruist to produce a Rule 30(b)(6) designee but did require Rosenruist to respond with the aforementioned declaration, the magistrate judge issued an order "grant[ing] in part and deny[ing] in part" VEL's motion to compel. J.A. 381. Following the hearing, Rosenruist filed a declaration stating that there was "no officer, director, or managing agent or other person who consents to testify on Rosenruist's behalf in this District," J.A. 414.

VEL filed objections to the magistrate judge's order, arguing that 35 U.S.C.A. § 24 did not limit "witness" to natural persons and that, therefore, a corporation could be compelled to appear at a deposition regardless of where the Rule 30(b)(6) designee might personally reside. The district court again concluded that the ruling of the magistrate judge was not clearly erroneous or contrary to law. VEL then filed this appeal.

II.

Before turning to the particular arguments of the parties, we believe it is helpful to consider very briefly the role of the district court in the context of an opposition proceeding before the TTAB, as well as the interplay between the Federal Rules of Civil Procedure and the PTO's rules of procedure.

The TTAB is an administrative tribunal of the PTO with jurisdiction over *inter partes* challenges to the registration of trademarks. *See* 15 U.S.C.A. § 1067(a)

(West Supp.2007).[4] Procedure in *inter partes* matters diverges from that in district court at the trial stage, in that the taking of testimony does not occur in the presence of the TTAB. Instead, testimony is taken by deposition during set testimony periods, and the TTAB resolves all factual issues based on the written record submitted by the parties. *See* 37 C.F.R. §§ 2.121, 2.123, 2.125 (2006).

Inter partes proceedings before the TTAB are governed by the Rules of Practice in Trademark Cases adopted by the PTO and set forth in Part 2 of Title 37 of the Code of Federal Regulations. *See* 35 U.S.C.A. § 23 (West 2001) (granting the Director of the PTO the authority to "establish rules for taking affidavits and depositions required in cases in the [PTO]"). The PTO's rules were "adapted from the Federal Rules [of Civil Procedure], with modifications appropriate to the administrative process." *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1575 (Fed.Cir.1988). Under the PTO's rules, the Federal Rules of Civil Procedure generally apply to all phases of *inter partes* proceedings, *see* 37 C.F.R. § 2.116(a), including discovery and the taking of depositions, *see* 37 C.F.R. § 2.120(a).

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4. An *inter partes* proceeding before the TTAB is an adversarial action between parties regarding the registrability of a proposed trademark. An *inter partes* proceeding can take the form of an opposition proceeding, *see* 15 U.S.C.A. § 1063 (West 1997 & Supp.2007); a cancellation proceeding, *see* 15 U.S.C.A. § 1064 (West 1997 & Supp.2007); an interference proceeding, *see* 15 U.S.C.A. § 1066 (West Supp.2007); or a concurrent use proceeding, *see* 37 C.F.R. § 2.42 (2006).

As an administrative tribunal of limited jurisdiction, the TTAB is empowered only to decide whether a given trademark is registrable. *See* 15 U.S.C.A. §§ 1067, 1068 (West Supp.2007); 15 U.S.C.A. § 1070 (West 1997); *Person's Co. v. Christman*, 900 F.2d 1565, 1571 (Fed.Cir.1990). Although the TTAB has the authority to impose limited sanctions upon *parties* that fail to cooperate during discovery, *see* 37 C.F.R. §§ 2.120(e), (g), the TTAB lacks the authority to compel witnesses through the subpoena power to appear for testimony in *inter partes* proceedings. *See* 37 C.F.R. § 2.120(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 U.S.P.Q. 582, 583 (T.T.A.B.1976).

Accordingly, Congress granted district courts subpoena authority under 35 U.S.C.A. § 24 to command the appearance of witnesses in administrative proceedings before the PTO. *See Frilette v. Kimberlin*, 508 F.2d 205, 207 (3d Cir.1975) (en banc); *Vogel v. Jones*, 443 F.2d 257, 259 (3d Cir.1971). Under this statute, district courts have "jurisdiction to . . . issu[e] . . . subpoenas" in PTO proceedings. *Frilette*, 508 F.2d at 207. This narrow jurisdictional grant assigns district courts the limited function in contested PTO matters of "issu[ing] and enforc[ing] subpoenas in connection with the preparation of evidence for submission" to the administrative tribunal. *Id.* at 209. Thus, § 24 assigns a supportive role to the district courts to ensure the smooth functioning of the procedures adopted by the PTO. *See id.* at 210 (describing the function of the district court as "co-operatively complementing" the PTO) (internal quotation marks omitted).

Appendix A

A.

With this context in mind, we turn to VEL's challenge to the conclusion of the magistrate judge that "witness" in 35 U.S.C.A § 24 refers only to natural persons and not to corporations or other juristic persons. The effect of the magistrate judge's conclusion was that, despite the fact that Rosenruist *itself* was properly served a valid subpoena directing it to designate a corporate representative for a Rule 30(b)(6) deposition of the *corporation*, the court could not require Rosenruist to produce its designee unless the designee was "residing or being within" the Eastern District of Virginia.

For the reasons set forth below, we agree with VEL that the term "witness," as used in the statute, is not limited to natural persons and allows the court to reach corporations and other juristic persons. Because the unappealed order of March 2, 2006, established for purposes of this case that the subpoena was valid and that Rosenruist, as the subject of the subpoena, was required to obey it, it follows that the district court should have granted VEL's motion to compel.

1.

As we noted above, the PTO's rules of practice generally incorporate the deposition procedures prescribed by the Federal Rules of Civil Procedure, specifically including Rule 30(b)(6). *See* 37 C.F.R. § 2.120(b) (2006). Pursuant to Rule 30(b)(6), a party may

name a *corporation* as a deponent, in either a notice of deposition or a subpoena:

> A party may in the party's notice and in a subpoena name as the deponent a public or private corporation or a partnership or association or governmental agency and describe with reasonable particularity the matters on which examination is requested. In that event, the organization so named shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify.

Fed.R.Civ.P. 30(b)(6).

Prior to the adoption of this rule in 1970, a party wishing to establish the knowledge of a corporate entity was forced to identify and subpoena a specific officer or representative of the corporation who qualified as a director, officer, or managing agent. *See Founding Church of Scientology of Washington, D.C., Inc. v. Webster*, 802 F.2d 1448, 1451 (D.C.Cir.1986). That practice was supplemented with the addition of Rule 30(b)(6), which allows the examining party to seek the corporation's testimony without regard to who actually provides the testimony on behalf of the organization. If "[t]he party seeking discovery . . . simply name[s] the corporation . . . as the deponent," it becomes "the duty of the corporation to name one or more persons who

consent to testify on its behalf . . . as to matters known or reasonably available to the corporation." 8A Charles Alan Wright, Arthur R. Miller, & Richard L. Marcus, *Federal Practice and Procedure* § 2102, at 30-31 (2d ed.1994). Essentially, "[i]n a Rule 30(b)(6) deposition, there is no distinction between the corporate representative and the corporation." *Sprint Commc'ns. Co. v. Theglobe.com, Inc.*, 236 F.R.D. 524, 527 (D.Kan. 2006).

Thus, like any person named in a subpoena to appear as a deponent or witness, a corporation may be named in a subpoena issued under Rule 45, which "command[s] each *person* to whom it is directed to attend and give testimony" at a trial or deposition. Fed.R.Civ.P. 45(a)(1)(C) (emphasis added); *see* Fed.R.Civ.P. 30(a)(1) ("A party may take the testimony of any *person*, including a party, by deposition upon oral examination. . . .") (emphasis added). Thus, the word "person" in Rule 45 is not limited merely to "natural persons" but includes juristic persons like corporations and governments as well. *Cf. Yousuf v. Samantar*, 451 F.3d 248, 257 (D.C.Cir.2006) (explaining that "[t]he term 'person' as used in the Federal Rules of Civil Procedure consistently means . . . natural persons and business associations . . . [as well as] governments" and holding that "the Government is a 'person' subject to subpoena under Rule 45").

If a party to an *inter partes* proceeding wishes to take the trial testimony of an adverse party or an official of an adverse party who is unwilling to appear voluntarily, then the examining party must secure attendance of the deponent by subpoena. *See Health-Tex, Inc. v. Okabashi*

(U.S.) Corp., 18 U.S.P.Q.2d 1409, 1410 (T.T.A.B.1990). As mentioned previously, the TTAB is not vested with the power to subpoena witnesses in *inter partes* PTO cases. Under 35 U.S.C.A. § 24, Congress instead granted to district courts the power to enforce the rights of litigants to secure the presence of witnesses in contested proceedings in the PTO: "The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any *witness* residing or being within such district . . " 35 U.S.C.A. § 24 (emphasis added).

We agree with VEL that the "witness" is not limited only to natural persons. The PTO regulations expressly contemplate the use of Rule 30(b)(6) depositions in which the corporation is the "person" named in the subpoena as the deponent. *See* 37 C.F.R. §§ 2.120(b), 2.124(b)(2). Nothing in the text of 35 U.S.C.A. § 24 suggests to us that, in the context of a contested PTO action, the interplay between Federal Rules 30(b)(6) and 45 operates differently. Indeed, the statute expressly provides that, in contested PTO cases, "[t]he provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses . . . shall apply." 35 U.S.C.A. § 24. Nor do we see anything in the statute indicating that Congress wished to tie the court's power to subpoena corporate testimony under Rule 30(b)(6) to the personal residence of the individuals ultimately designated by the corporation to testify on its behalf. Foreign corporations that are subject to the personal jurisdiction of a district

court can be and often are required to produce officers, directors, or managing agents—regardless of where such witnesses personally reside—in the United States for a Rule 30(b)(6) deposition. *See Custom Form Mfg., Inc. v. Omron Corp.*, 196 F.R.D. 333, 336 (N.D.Ind.2000); *In re Honda Am. Motor Co. Dealership Relations Litig.*, 168 F.R.D. 535, 540-42 (D.Md.1996).

Accordingly, we do not agree with the magistrate judge's narrow interpretation of "witness," and we hold that corporations, as well as natural persons, are subject to the issuance of Rule 30(b)(6) subpoenas pursuant to 35 U.S.C.A. § 24. And, as a result, we believe the magistrate judge incorrectly concluded that Rosenruist could avoid designating and producing a Rule 30(b)(6) deponent because none of its potential designees were personally "residing or being within" the Eastern District of Virginia.

2.

Rosenruist contends that even if the corporation itself can be considered a "witness" under 35 U.S.C.A. § 24, rendering the individual designee's residence or location irrelevant for purposes of a *corporate* subpoena, the subpoena was invalid because Rosenruist itself was not "residing or being within" the district. Rosenruist has not developed this argument except to assert that it lacks the required presence because it "has no business activities, no managing agents, and no agents consenting to testify within the district or anywhere in the U.S." Brief of Appellee at 25. Additionally, Rosenruist points

out, the designation of a statutory agent for service under 15 U.S.C.A. § 1051(e) is not sufficient to subject a corporation to the court's subpoena power under § 24.

Rosenruist also contends that the subpoena was not valid because the Rosenruist corporation lacked the "continuous and systematic contacts" with the Eastern District of Virginia necessary to support the district court's exercise of *in personam* jurisdiction. *Helicopteros Nacionales de Colombia, S.A. v. Hall*, 466 U.S. 408, 416, 104 S.Ct. 1868, 80 L.Ed.2d 404 (1984); *see Ratliff v. Cooper Labs., Inc.*, 444 F.2d 745, 748 (4th Cir.1971) (concluding that the designation of a statutory agent for service was insufficient to confer general jurisdiction over an out-of-state corporation).

Although Rosenruist advances these arguments as separate challenges to the validity of the subpoena, they are essentially one and the same argument—that Rosenruist is not subject to the court's subpoena power under § 24 because Rosenruist lacks sufficient contacts in the Eastern District of Virginia. We infer that Rosenruist views the "residing or being" requirement of § 24 as commensurate with the requirements for a court's exercise of general jurisdiction over a party.

We conclude these arguments are not properly before the panel because the validity of the subpoena has already been determined. Thus, we need not determine precisely what is required for a witness to satisfy the statute's "residing or being" component, although we find no support for the notion that the

statute requires the "systematic and continuous" presence needed for the exercise of general jurisdiction.[5]

The March 2, 2006, order rejected Rosenruist's motion to quash in which Rosenruist asserted in part that it was not subject to the court's subpoena power. The order established that the subpoena was valid and that the requirements of 35 U.S.C.A. § 24 had been satisfied. Rosenruist did not appeal this ruling.

Subsequently, in its opposition to VEL's motion to compel a Rule 30(b)(6) designation and appearance, Rosenruist argued that the court lacked *in personam* jurisdiction over it and therefore could not enforce the subpoena against it. The court effectively rejected Rosenruist's jurisdictional argument and reiterated that Rosenruist was subject to the subpoena when it granted VEL's motion in part and ordered Rosenruist to designate a Rule 30(b)(6) witness or submit a declaration that no qualifying witness resided or was present within the district. The court, however, refused to require an appearance. VEL, of course, appealed the latter portion of the order, and that appeal is before us now. Rosenruist did not file a cross-appeal.

A prevailing party may urge an appellate court "to affirm a judgment on any ground appearing in the record," *Toll Bros., Inc. v. Dryvit Sys., Inc.*, 432 F.3d 564, 572 (4th Cir.2005), and may do so without having to

5. Were the issue before us, however, we would conclude that Rosenruist's activities in this case were sufficient to qualify it as "being within [the] district."

file a cross-appeal, *see Blum v. Bacon*, 457 U.S. 132, 137 n. 5, 102 S.Ct. 2355, 72 L.Ed.2d 728 (1982). If the prevailing party raises arguments that seek to alter or modify the judgment below, then a cross-appeal is required. *See El Paso Nat. Gas Co. v. Neztsosie*, 526 U.S. 473, 479, 119 S.Ct. 1430, 143 L.Ed.2d 635 (1999) ("Absent a cross-appeal, an appellee may urge in support of a decree any matter appearing in the record, although his argument may involve an attack upon the reasoning of the lower court, but may not attack the decree with a view either to enlarging his own rights thereunder or of lessening the rights of his adversary." (internal quotation marks omitted)); *see also JH ex rel. JD v. Henrico County Schl. Bd.*, 326 F.3d 560, 567 n. 5 (4th Cir.2003) ("The general rule is that without taking a cross-appeal, the prevailing party may present any argument that supports the judgment in its favor as long as the acceptance of the argument would not lead to a reversal or modification of the judgment. . . ." (internal quotation marks and alteration omitted)).

Here, Rosenruist asks us to affirm the court's refusal to require it to produce a Rule 30(b)(6) witness as commanded by the subpoena based on Rosenruist's lack of presence and the issuing court's lack of personal jurisdiction. As explained previously, the court below clearly concluded that the subpoena was valid and that Rosenruist *as a corporation* was subject to the subpoena. Thus, these particular arguments, were the panel to accept them, would require us to modify the court's judgment below and enlarge Rosenruist's rights thereunder. Because Rosenruist did not assert a cross-appeal, we decline to consider these issues.

B.

Rosenruist next contends that § 24 was enacted only to enforce the rules and procedures developed by the PTO, and VEL's reading of the statute will permit it to exercise procedural rights beyond those established by the PTO. *See Frilette*, 508 F.2d at 209-11 (rejecting the notion that 35 U.S.C.A. § 24 allows a party to bootstrap itself into additional means of discovery not provided by the PTO).

Relying on the TBMP (the TTAB's Manual of Procedure) Rosenruist suggests that the PTO's rules do not permit the attendance of a foreign witness to be secured by a subpoena. According to the TBMP, a "party [who] wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States . . . [who] is not willing to appear voluntarily to testify . . . must secure the attendance of the witnesses by subpoena." TBMP § 703.01(f)(2). The TBMP provides that for an unwilling witness who resides in a foreign country, however, "[t]here is no certain procedure for obtaining . . . the trial testimony deposition of [such] a witness" and that the deposing party may obtain such testimony through "the letter rogatory procedure or the Hague Convention letter of request procedure." TBMP § 703.01(f)(3).

It is important to recognize that the TBMP is simply a manual issued by the TTAB "to practitioners with basic information generally useful for litigating cases before

the [TTAB]," which expressly acknowledges that it "does not modify, amend, or serve as a substitute for any statutes, rules or decisional law and is not binding upon the [TTAB]." TBMP, Intro. The TBMP does not provide, or even purport to provide, authoritative interpretive guidance with regard to the scope of 35 U.S.C.A. § 24 or any other statute. Rather, it merely sets forth the TTAB's informal opinion that the statute does not provide authority for a district court to issue a subpoena to an unwilling foreign deponent. We are neither bound by the TBMP nor obligated to consider its statutory interpretation particularly persuasive.

We conclude that reading the statute to permit the issuance of a Rule 30(b)(6) subpoena to Rosenruist does not expand or add to the procedures established by the PTO. As noted above, the PTO's rules of procedure allow for the use of Rule 30(b)(6) depositions in *inter partes* cases and permit the taking of trial testimony "by depositions upon oral examination." 37 C.F.R. § 2.123(a); *see id.* § 2.123(c) ("Depositions may be noticed for any reasonable time and place in the United States.").[6] The issue here simply involves the extent of the district

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6. The regulations relied upon in the dissenting opinion pertain to *discovery* depositions, *see* 37 C.F.R. §§ 2.120(b), (c), as opposed to the testimonial depositions at issue here. As such, these regulations do not support the premise that our decision permits VEL to use § 24 as a means of circumventing the PTO's procedures. Likewise, 37 C.F.R. § 2.123(a)(2) is of no use in this case because it applies only when a party seeks to take a testimonial deposition *in a foreign country;* VEL, of course, does not desire to do so.

court's subpoena power under § 24 to ensure that parties are able to use the existing PTO *inter partes* procedures. VEL is not seeking to exercise a right or use a procedure that the PTO has not provided.

C.

Finally, Rosenruist argues that the service of the subpoena was ineffective because it failed to comply with Rule 45(b)(1), which requires the witness fee and reasonably estimated mileage to be tendered at the time of service. *See* Fed.R.Civ.P. 45(b)(1); *In re Dennis*, 330 F.3d 696, 705 (5th Cir.2003). We reject this argument. In the March 2, 2006, order denying Rosenruist's motion to quash, the magistrate judge determined that service was effective. Rosenruist did not appeal that order. The magistrate judge also reiterated that conclusion in the May 2, 2006, order which is the subject of this appeal. Because Rosenruist did not cross-appeal this portion of the court's decision, we decline to address it. *See Pritchett v. Alford*, 973 F.2d 307, 315 (4th Cir.1992).

III.

For the foregoing reasons, we reverse the order of the district court denying VEL's motion to compel Rosenruist to obey the subpoena, and we remand for further proceedings consistent with this opinion.

REVERSED AND REMANDED

WILKINSON, Circuit Judge, dissenting:

In a first for any federal court, my colleagues hold that a foreign company that has no United States employees, locations, or business activities must produce a designee to testify at a deposition in the Eastern District of Virginia so long as it has applied for trademark registration with a government office located there. 35 U.S.C. § 24 (2000). As a result, foreign witnesses can be compelled to travel to the United States and give in-person deposition testimony at the behest of any litigant in a trademark dispute, "for use in any contested case in the Patent and Trademark Office" ("PTO")—though the PTO's own procedures call for obtaining testimony from foreign companies through other means. *Id.*

The majority's holding that this subpoena is enforceable is problematic for many reasons. It fails to properly apply the statute, 35 U.S.C. § 24, that is directly relevant to its decision, and it reaches a result that is bound to embroil foreign trademark applicants in lengthy, procedurally complex proceedings. It inverts longstanding canons of construction that seek to protect against international discord, and it disregards the views of the PTO whose proceedings 35 U.S.C. § 24 is designed to aid. In view of the statutory text (*see* Section I), interpretive canons, international relationships, and separation of powers concerns (II), and the PTO's own framework (III), I firmly believe this subpoena must be quashed.

I recognize this is an extensive dissent. However, the brevity of the majority's conclusion belies its significance. No matter how one cuts the cookie, the bottom line is that the majority enforces the subpoena. In so doing, the majority creates a standard that is in fact a national one: the PTO is located in the Eastern District of Virginia; applications for trademark registration are filed there; and subpoena enforcement will frequently be sought in that district. Indeed, for any foreign corporation without a pre-existing United States presence, the majority's decision will be controlling. For this reason, among others, I think this decision is unfortunate. The decision to extend the subpoena power under 35 U.S.C. § 24 to foreign companies situated similarly to Rosenruist is one that is plainly before this court, and its importance warrants full discussion.

I.

The first obstacle to the majority's view is the language of the statute itself. The statute provides,

> The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for *any witness residing or being within such district*, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena.

35 U.S.C. § 24 (emphasis added). The majority argues correctly that Rosenruist is a "witness" under this provision. My colleagues hold properly that the term " 'witness' is not limited only to natural persons." *Ante* at 446. "[C]orporations, as well as natural persons, are subject to the issuance of Rule 30(b)(6) subpoenas pursuant to 35 U.S.C. § 24." *Ante* at 445-46. This is correct, and I agree with it fully.

The majority then gives short shrift, however, to the statute's very next words, which state that a party in patent proceedings may seek to subpoena only a "witness *residing or being within such district.*" *Id.* (emphasis added). Through a strained interpretation of this case's procedural posture, the majority first claims that the issue of whether Rosenruist is "residing or being" within the Eastern District of Virginia is "not properly before the panel because the validity of the subpoena has already been determined." *Ante* at 446. Thus, the majority seems content to interpret only half of the relevant statutory phrase.

However, the majority then issues a conclusory statement, albeit in dicta, that "Rosenruist's activities in this case were sufficient to qualify it as 'being within [the] district.' " *Ante* at 446 n. 5. It is not a good idea to have a single sentence of dicta pass upon matters of such foreign and domestic import. As a result, the majority expresses its view on the merits in a manner that avoids any need for explication, but is simultaneously bound to influence how district courts interpret this enactment.

The upshot of this ruling is painfully clear. The majority first entangles foreign trademark applicants in a procedural web by misapplying basic principles of appellate process. It then flatly and wrongly concludes that the statute affords no protection to the prospective trademark registrants.

A more effective one-two punch could not have been landed upon foreign trademark applicants. Because I think that the question of the statute's application is clearly before us and that Rosenruist cannot be described, under any reasonable interpretation of 35 U.S.C. § 24, as "residing or being" within the Eastern District of Virginia, I respectfully dissent from both the majority's procedural and substantive conclusions.

A.

Because, through any lens, 35 U.S.C. § 24 is integral to the resolution of this case, I begin with a discussion of the statute itself. In plain language, the statute limits the geographic scope of a PTO litigant's subpoena powers to those "residing or being" within a U.S. judicial district. In ordinary use, limiting compulsory depositions to witnesses "residing or being" within a district requires a physical presence or at least sustained contacts in a district. *The Random House Dictionary of the English Language*, for example, defines to "reside" as "to dwell permanently or for a considerable time," and defines "to be" as "to exist or live" or "to occupy a place or position."

Appendix A

Random House Dictionary of the English Language (2d. ed.1987).[1]

The PTO itself has embraced a geographically constrained view of the subpoena powers that § 24 confers with respect to its proceedings. Its clearest guidance on this matter comes from its Trademark Trial and Appeal Board Manual of Procedure. The manual states that a district in which a domestic witness is "residing or being" is a district "where the witness resides or is regularly employed." Trademark Trial and Appeal Board Manual of Procedure ("TTAB Manual") § 703.01(f)(2) (2d ed. revision 1, 2004). If a PTO litigant wishes to obtain testimony of an unwilling adverse party, the litigant "must secure the attendance of the witness by subpoena . . . pursuant to 35 U.S.C. § 24 and Fed.R.Civ.P. 45, from the United States district court in the Federal judicial district *where the witness resides or is regularly employed.*" *Id.* (emphasis added). As the majority notes, the manual does not substitute for the statute itself or for the PTO's regulations, *ante* at 448, but the manual is entitled to respect as the PTO's own description of its "current practice and procedure under the applicable authority." *See* TTAB Manual, Introduction.

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1. Section 24's limitation to witnesses "residing or being" in a district is virtually unique and has not been the subject of prior judicial construction. Only three provisions of the U.S.Code, including this one, contain the "residing or being" phrase. *See* 7 U.S.C. § 2354(a) (2000) (subpoena power for contested cases in Plant Variety Protection Office); 50 U.S.C. § 207 (2000) (Civil War-era statute concerning "commercial intercourse by and between persons residing or being within districts within the lines of national military occupation in the States ...").

Appendix A

B.

Rosenruist, a Portuguese company, cannot be described as "residing or being" in the Eastern District of Virginia within the meaning given to these terms by the PTO or indeed with any meaning consistent with ordinary use. Rosenruist has no physical or commercial presence in the district, and no officers or employees either there or anywhere in the United States. It has no facilities, buildings, or operations in the Eastern District and has not carried out commercial activities there or elsewhere in the country.

Virgin Enterprises Ltd. ("VEL"), which seeks in-person depositions in the United States with Rosenruist officials, argues that Rosenruist can nevertheless be compelled to testify because it has filed an application for trademark registration with a government office located within the Eastern District of Virginia, and is "affirmatively press[ing] a claimed right to issuance of a United States trademark registration." *Brief of Appellant* at 37. But a person or company is no more "residing or being" within a district by virtue of seeking trademark protection with an office located there than a person would be "residing or being" within a district because he or she applied for a license without so much as setting foot in the territory. Filing an application with a government office is a contact within a jurisdiction, but it does not establish a physical presence or sustained contact akin to a presence within a district.

Appendix A

This trademark application and the attendant proceedings are Rosenruist's sole contacts with the district—as evidenced by the way in which VEL subdivides paperwork and proceedings surrounding the single trademark application in an effort to portray multiple, incidental contacts. Rosenruist designated attorneys as its representatives for service of process in proceedings affecting its proposed trademark, under a statute providing that if a company does not name a representative, the Director of the Patent and Trademark Office will be designated to fill the role. 15 U.S.C. § 1051(e) (2000). Appointment of an agent for service of process is a contact so minimal that our circuit has held it cannot render a company subject to judicial compulsion under *any* statute consistent with Due Process principles limiting personal jurisdiction, much less under a statute whose language requires more than the constitutional minimum. *Ratliff v. Cooper Labs.*, 444 F.2d 745, 748 (4th Cir.1971). Moreover, under § 1051, a trademark applicant always has a representative for service of process as a result of registering a mark, whether by designation or default—making this so-called contact no more than an aspect of filing a trademark application with the PTO.

Nor can the existence of a case before the PTO mean that Rosenruist is "residing or being" within the Eastern District of Virginia. VEL contested Rosenruist's trademark application by filing an opposition, *see* 15 U.S.C. § 1063 (2000), generating a "contested case in the Patent and Trademark Office," in which Rosenruist is the defendant. But this is also a consequence that may

obtain whenever a company files an application for a trademark, because other companies or persons are free to contest trademark registrations. Moreover, the existence of a "contested case in the Patent and Trademark Office" is itself a precondition for a subpoena under § 24, separate from the statute's second requirement that witnesses can only be subpoenaed in a United States judicial district in which they are "residing or being." It is highly implausible that Congress meant this separate "residing or being" limitation to allow any witness, domestic or foreign, to be subpoenaed in the Eastern District whenever the statute's apparently distinct first requirement is satisfied and there is a "contested case" in the PTO.

In sum, the only contacts Rosenruist has had with the Eastern District of Virginia are the de minimis contacts from the act of filing for trademark registration itself. This does not entitle VEL to enforcement of the subpoena. Whatever consequences may ensue from Rosenruist's failure to appear is something Rosenruist might wish to ponder, but the only question before us is whether the subpoena must be quashed. I believe it must be. No matter how many times the act of filing for a trademark application is repackaged and restated by VEL, this act does not make up for the lack of any physical facilities, business activities, or company employees within a district sufficient to render a Portuguese company "residing or being" within the district. This is true under the PTO's own definition or under any definition consistent with the ordinary meaning of the limiting language enacted by Congress.

C.

There is thus no question that 35 U.S.C. § 24 does not permit this subpoena to be enforced. The majority—in enforcing the subpoena and in concluding flatly that "Rosenruist's activities in this case were sufficient to qualify it as 'being within [the] district' " —manages astonishingly to say that the issue of the subpoena's enforcement pursuant to 35 U.S.C. § 24 is somehow not before the court. *Ante* at 447. This is too clever by half. The district court's ultimate judgment was that Rosenruist could not be compelled to give an in-person deposition because the conditions of 35 U.S.C. § 24 had not been met. *See ante* at 443. The majority, however, discusses who may be a "witness" under 35 U.S.C. § 24 and then re-labels the "residing or being" requirement of § 24 as a question bearing upon the "validity" of the subpoena, as though that will somehow make the statute go away. *See ante* at 444-47. But courts cannot interpret one word in a prepositional phrase and ignore another. By picking only selective portions of § 24 to interpret, the majority manages to enforce the subpoena, in violation of the explicit standard Congress has given us to apply.

With its actions, the majority ignores the fact that, as an appellate court, we sit to review *judgments*, not the reasons underlying such judgments. The district court rejected VEL's objections to the magistrate's denial of VEL's motion to compel Rosenruist's appearance at a deposition in this country. This is the judgment order VEL appeals. But the majority has elevated reasons into

judgments. In focusing on the district court's construction of the term "witness," the majority fails to consider an alternate and valid reason for affirming the district court's judgment—namely, that Rosenruist cannot be deemed to "be" or "reside" within the district as § 24 requires. The majority cleaves § 24 in two, and finds that the district court rested its judgment on only part of the statute in question. But this is not the case: the enforceability of the subpoena rests on both the "witness" and the "residing or being" requirements, and we review the district court's judgment that the subpoena is not enforceable as to Rosenruist's deposition as a whole.

This is precisely how the parties understood the issue on appeal. *See Brief of Appellant* at 3 ("This case concerns the scope of the District Court's subpoena power under 35 U.S.C. § 24."); *Brief of Appellee* at 4 (at issue is "whether the district court correctly denied VEL's motion to compel, subsequent to the Court's satisfying itself that Rosenruist had no 'witness' under 35 U.S.C. § 24 residing or being in the district"). Rosenruist is seeking to affirm the judgment declining to enforce the subpoena, not to modify any part of it, and a party seeking affirmance of a judgment need not lodge a cross-appeal to have that affirmance rest on an alternate ground. In view of the fact that this is a single judgment, and Rosenruist prevailed on that judgment, one cannot possibly saddle Rosenruist—as the majority has—with the obligation to file a cross-appeal. This at best creates busy work and at worst compounds the procedural snares the majority has devised for foreign companies at the outset of their trademark applications.

Furthermore, despite what I respectfully suggest is an incorrect rendering of the case's procedural posture, the majority cannot hide the true import of its opinion: that this subpoena is in its view perfectly enforceable. The majority reaches this conclusion by eschewing any interpretation of the "residing or being" language of 35 U.S.C. § 24, while at the same time expressing unequivocally its view on the merits of this question in a conclusory footnote. *Ante* at 446 n. 5. This unexplained declaration is also error. It is inescapable that Rosenruist is not "residing or being" within the Eastern District of Virginia. Therefore, the subpoena may not be enforced.

II.

A.

My problems with the majority's decision do not end with what I respectfully suggest is its erroneous and conclusory view of 35 U.S.C. § 24. I also disagree with the disregard of cautionary canons of interpretation that apply to statutes bearing upon other nations' interests and international norms. The reach of American law in "situations involving one or more foreign contacts," *Romero v. Int'l Terminal Operating Co.*, 358 U.S. 354, 382, 79 S.Ct. 468, 3 L.Ed.2d 368 (1959), is constrained by maxims that "protect against unintended clashes between our laws and those of other nations which could result in international discord," *EEOC v. Arabian American Oil Co.*, 499 U.S. 244, 248, 111 S.Ct. 1227, 113 L.Ed.2d 274 (1991) (citing *McCulloch v. Sociedad Nacional de Marineros de Honduras*, 372 U.S. 10, 20-

22, 83 S.Ct. 671, 9 L.Ed.2d 547 (1963)). The majority decision risks such disruption by enabling litigants to compel in-person depositions from foreign companies with the most minimal U.S. contacts, as a condition of those companies obtaining a legal protection that is critical to international commerce.

A sense of comity, not needless friction, should govern this whole area. The contours of the "rule of construction . . . derived from the principle of 'prescriptive comity,' " *Hoffmann-La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155, 164, 124 S.Ct. 2359, 159 L.Ed.2d 226 (2004) (internal citations omitted), are fatal to the majority's view of § 24. The rule requires that judges "ordinarily construe[ ] ambiguous statutes to avoid unreasonable interference with the sovereign authority of other nations" and assumes "that legislators take account of the legitimate sovereign interests of other nations when they write American laws." *Id.* While the majority of course is not trying to tell Portuguese authorities how to enforce Portuguese law, it is wading into international waters, not only without congressional authority but in the face of contrary congressional intent. All canons of statutory construction mandate caution in this context. By brushing aside 35 U.S.C. § 24 as well as the canons that should inform its construction, the majority instead mandates maximum levels of foreign corporate exposure to American judicial process. This approach does anything but help "the potentially conflicting laws of different nations work together in harmony . . . particularly needed in today's highly interdependent commercial world." *Hoffmann-La Roche*, 542 U.S. at 164-65, 124 S.Ct. 2359.

This presumption of comity, so helpful to good will and active commerce among nations, exists even with respect to statutes that specify no geographic limit. It emphatically exists with respect to statutes such as § 24 whose terms indicate that Congress wanted a limited territorial reach. Courts work from the "commonsense notion that Congress generally legislates with domestic concerns in mind." *Small v. United States*, 544 U.S. 385, 388, 125 S.Ct. 1752, 161 L.Ed.2d 651 (2005) (quoting *Smith v. United States*, 507 U.S. 197, 204 n. 5, 113 S.Ct. 1178, 122 L.Ed.2d 548 (1993)). Indeed, courts do so even when "the more natural reading of the statutory language" would be to include foreign companies or conduct. *Hoffmann-La Roche*, 542 U.S. at 174. For instance, *Small* held that a statute referring to a person "convicted in *any court*" did not apply to persons convicted in foreign courts, in part by invoking canons counseling limited construction of general statutes in international contexts. 544 U.S. at 388, 125 S.Ct. 1752 (emphasis added). It cannot be contended that these canons somehow do not apply to § 24, which is not even written in universal terms, but contains terms of geographic limitation.

These interpretive principles are too important for my good colleagues simply to ignore. It hardly respects the legitimate interests of other nations, *see Hoffmann-La Roche*, 542 U.S. at 164, 124 S.Ct. 2359, to allow litigants to compel in-person testimony in the Eastern District from representatives of foreign companies whose only act within our borders has been the filing of a trademark application. In giving regard to other

nations' interests, the Supreme Court has held that judges "must assume" Congress ordinarily seeks to follow the Restatement of Foreign Relations Law in determining whether a U.S. statute applies. *Id.* at 164, 124 S.Ct. 2359. The Restatement provides that a nation will not exercise its jurisdiction "when the exercise of such jurisdiction is unreasonable," *Rest. (Third) Foreign Rels. Law* § 403(1) (2006), and that a foreign person or company's "connections, such as nationality, residence, or economic activity" to the state are one relevant consideration, *id.* § 403(2)(b). To make the price of a simple trademark application an overseas trip by a company officer or officers to answer a deposition is to impose a substantial burden from a minimal connection.

I realize that when a subpoena is served upon a corporation, the corporation can designate whom it wishes to produce for the subpoena. *See* Fed R. Civ. P. 30. But this provides no meaningful relief, because an organization's Rule 30 designee must be fully prepared to "testify as to matters known or reasonably available to the organization." Fed.R.Civ.P. 30(b)(6). The heart of Rosenruist's predicament is that it has no U.S. employees or U.S. operations, and consequently that no person within this country is equipped to testify "as to matters known or reasonably available" to the company. *Id.* VEL is surely correct that Rosenruist could change this, but only at considerable expense and over time. Rosenruist could hire a lawyer or other U.S. resident to serve as its representative for Rule 30 purposes, and provide the newly minted designee with a crash course in the matters of corporate strategy and intellectual

property on which the company's testimony was sought. But a company's right to pay for a capable U.S.-based representative and then divert its officers to fully prepare the representative is hardly a compliance option that renders the extension of § 24 to foreign companies such as Rosenruist a minimal imposition.

It may or may not be burdensome for the designee of a company large or small to fly from Portugal or India or Japan for a deposition in the Eastern District of Virginia. It may be that technology in time may provide less burdensome alternatives. District courts always have the power to quash subpoenas as posing an "undue burden," but litigation over burdensomeness is not inconsequential and imposes a burden in its own right upon trademark applicants. *See* Fed.R.Civ.P. 45. If Congress had struck a balance that imposed these costs upon foreign companies with de minimis United States contacts, that would be one thing, but for courts to impose these burdens based upon a foreign company's minimal contacts here reads a statute that is at best ambiguous in a manner that impinges on other nations' interests and risks at least a measure of international discord.

B.

The majority's disregard for these cautionary canons of construction invites retaliatory actions of all sorts. The Supreme Court has sought to avoid applications of U.S. statutes to foreign companies or conduct that could generate "retaliatory action from other nations,"

McCulloch, 372 U.S. at 21, 83 S.Ct. 671, and "disrupti[on] of international commerce," *Romero*, 358 U.S. at 384, 79 S.Ct. 468. Yet the new burden that the majority places upon foreign companies to give in-person depositions in our country simply because they filed for registration of their trademark—a burden that so far as I can tell has never before been imposed by any court under § 24—risks just such retributive measures. It is simply unrealistic to suppose that other nations will sit quietly while their own companies and citizens are subjected to depositions in this country. It is thoroughly realistic to anticipate their imposing corresponding burdens and inconveniences upon Americans who seek trademark protection for their own activities abroad.

Congress has indicated that trademark protection is vital to commerce since it first made actionable "the deceptive and misleading use of marks" based upon the harms that such abuses cause to interstate commerce. 15 U.S.C. § 1127 (2000). It declared that the trademark system sought "to protect persons engaged in such commerce against unfair competition" that would ensue if one company could use another's name, logo, or other mark to benefit from the other's good will and sow confusion among consumers. *Id.* Foreign companies are no less dependent upon the protection of their products and properties for their commercial activities. The imposition of new burdens upon foreign companies, when they take no more than the first perfunctory step to register their trademark here, undermines a predicate of international commerce that a more modest conception of the judicial function would avoid.

The majority also fails to inquire as to "the degree to which the desirability of such regulation [subpoena authority] is generally accepted" and "the extent to which the regulation is consistent with the traditions of the international system," as well as "the character of the activity to be regulated." *Rest. (Third) Foreign Rels. Law* § 403(2)(c), § 403(2)(f). The majority does not ask whether, in authorizing subpoenas of foreign witnesses to the Eastern District of Virginia for in-person depositions, it is rebuking a consensus surrounding reciprocal reductions in barriers to the protection of intellectual property. Under the Madrid Protocol Relating to the Madrid Agreement Concerning International Registration of Marks, which the United States joined in 2003, an increasing number of nations permit the citizens of signatory states to seek trademark protection through a single transnational application, without filing new papers from country to country.[2] This agreement does not by any means decide the issue, but the reciprocal actions of these signatory nations suggest no basis in trademark law for the procedural hurdle that the majority today erects. And insofar as the Protocol indicates that a norm of reciprocity carries weight in this arena, other states could well consider my colleagues' imposition of this novel procedural hurdle upon their companies to be an invitation to impose corresponding retaliatory hurdles of their own.

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2. Signatory nations retain the right to refuse applications filed through this mechanism, and United States law provides for the filing of oppositions such as VEL's to applications submitted in this manner. *See* 15 U.S.C. § 1141h(a)(2); *see also* J. Thomas McCarthy, *3 McCarthy on Trademarks and Unfair Competition* § 19:31.50 (4th ed.2007).

Nor can the majority claim a basis for its decision by asserting that there is a need for in-person testimony in cases where a trademark holder claims that a foreign company has made or sold goods here that infringe an existing mark. Section 24, which applies only to PTO proceedings, does not in any way diminish the ability of trademark holders to bring infringement actions in federal court against companies that—unlike Rosenruist—distribute potentially infringing goods or conduct operations here. *See Steele v. Bulova Watch Co.*, 344 U.S. 280, 286-27, 73 S.Ct. 252, 97 L.Ed. 319 (1952). Section 24 does not bear upon the availability of in-person testimony in such infringement cases, because § 24 governs only PTO proceedings. *See* 35 U.S.C. § 24. A proper view of § 24 would do no more than protect companies such as Rosenruist that have taken only the first step to register their marks from the burdens of in-person depositions in cases before the PTO—burdens that can be adjusted by Congress as the exigencies of commerce and international trade require.

C.

Separation of powers considerations are present also. I recognize that the statute at issue here is one that regulates judicial process, an issue on which courts rightly claim an expertise. That does not change the equation, however. Congress regulates judicial process through rules and statutes too numerous to mention. None of this regulation affords courts the authority to displace congressional enactments on judicial process with their own. Notwithstanding the fact that 35 U.S.C.

§ 24 bears upon judicial process, the impact of in-person depositions of foreign companies in the Eastern District of Virginia is quite beyond the ken of judges. Courts have recognized consistently that we should act cautiously where foreign relations are in play, because other branches of government are best suited to make judgments in these areas. For instance, extraterritorial application of federal law has long been disfavored in part because "such a construction would have had foreign policy implications." *Weinberger v. Rossi*, 456 U.S. 25, 32, 102 S.Ct. 1510, 71 L.Ed.2d 715 (1982). And a narrow construction of the National Labor Relations Act has been justified where "international implications" would ensue from a broad one. *NLRB v. Catholic Bishop of Chicago*, 440 U.S. 490, 500, 99 S.Ct. 1313, 59 L.Ed.2d 533 (1979). It is essential to recognize the international ramifications that may ensue from far-reaching holdings such as this one, and to defer to the political branches, as the Supreme Court has long done, in a matter of some international delicacy.

Other statutes in fact suggest the judgment of my fine colleagues is not in line with the judgment of Congress. As noted earlier, the majority's decision seems in some tension with the Madrid Protocol's scheme of reciprocal reduction in barriers to intellectual property protections abroad. In addition, 28 U.S.C. § 1783 authorizes subpoenas of an *American* citizen or resident "who is in a foreign country" only upon a showing "that particular testimony or the production of the document or other thing by him is necessary in the interest of justice" and, in civil cases, "that it is not possible to obtain

his testimony in admissible form without his personal appearance or to obtain the production of the document or thing in any other manner." 28 U.S.C. § 1783(a) (2000). The high standard Congress has imposed upon litigants seeking to put even our own citizens to the expense and inconvenience of international travel to give a deposition here suggests that this court's unwarranted extension of subpoena powers is not just a judgment that should be left to Congress but a judgment that is out-of-step with Congress' approach.

III.

My friends in the majority not only make a policy decision that should be left to Congress, but also disregard the views of the most relevant expert agency in doing so. My colleagues disregard the limited view of the Patent and Trademark Office for whose sole benefit testimony under § 24 is intended, and authorize litigants to circumvent the framework that the PTO has established for obtaining testimony from foreign witnesses. This is unsound, both because of the PTO's expertise in trademark matters and because the text of § 24 indicates that it should be invoked only in aid of PTO proceedings—"for use in any contested case in the Patent and Trademark Office." 35 U.S.C. § 24.

A.

The Trademark Trial and Appeal Board's view that § 24 excludes foreign companies with minimal American contacts is evident from the record. The TTAB attorney

overseeing the instant dispute denied VEL's motion to compel Rosenruist to appear for an oral testimony deposition in its home country of Portugal, in a letter that indicated there was no ready mechanism for obtaining in-person depositions from foreign adverse parties. In particular, the attorney wrote, "where the adverse party or unwilling witness *resides in a foreign country*, the party seeking to take the testimony deposition of such witness *may not be able to do so absent the letter rogatory procedure or The Hague Convention letter of request procedure.*" (emphasis added).

The TTAB attorney relied upon the TTAB Manual, which likewise indicates that foreign companies like Rosenruist are not generally subject to compulsion under § 24 because they are not "residing or being" in any district of the United States. The manual's provisions on domestic and foreign witnesses present a striking contrast. The manual first indicates that parties to a PTO proceeding may use § 24 to subpoena domestic witnesses in the judicial districts where they reside or are employed. It provides,

> If a party wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena.

TTAB Manual § 703.01(f)(2). The subpoena "must be issued, pursuant to 35 U.S.C. § 24 and Fed.R.Civ.P. 45, from the United States district court in the Federal judicial district where the witness *resides or is regularly employed.*" *Id.* (emphasis added).

The immediately subsequent provision entitled "Unwilling witness residing in a foreign country," describes no role for § 24 with respect to such witnesses. It states, to the contrary,

> There is *no certain procedure* for obtaining, in a Board inter partes proceeding, the trial testimony deposition of a witness who resides in a foreign country, is an adverse party or a nonparty (or an official or employee of an adverse party or nonparty), and is not willing to appear voluntarily to testify.

TTAB Manual § 703.01(f)(3) (emphasis added); *see also* TTAB Manual § 703.01(f)(1) ("[W]here a party wishes to take the testimony of an adverse party or nonparty, or an official or employee of an adverse party or nonparty, and the proposed witness is not willing to appear voluntarily to testify . . . the party that wishes to obtain the deposition must take steps, discussed below, to compel the attendance of a witness. *If the witness resides in a foreign country, the party may not be able to take the deposition.*") (emphasis added).

The regulations governing PTO proceedings, while less explicit, fully support the TTAB Manual and the

TTAB hearing officer in concluding that a party cannot demand in-person oral testimony from a foreign party such as Rosenruist simply because the foreign party filed a trademark application. The regulations make no mention of subpoenaing foreign witnesses under § 24 for testimony or discovery depositions,[3] but they *do* describe § 24 as available to compel discovery depositions from persons who "live or reside" in the United States—indicating again that the agency construed § 24 as applicable only to witnesses that "live or reside" in the country. *Compare* 37 C.F.R. § 2.120(b) (2006) (stating that the discovery "deposition of a natural person shall be taken in the federal judicial district where the person *resides or is regularly employed* or at any place on which the parties agree by stipulation") (emphasis added) *with* 37 C.F.R. § 2.120(c) (providing for discovery depositions of representatives of foreign witnesses abroad on written questions unless the TTAB orders oral deposition on

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3. PTO proceedings have a discovery phase, in which discovery depositions are permitted, and a trial phase, in which testimony depositions are permitted, subject to somewhat more restrictive evidentiary and other limitations. *See* TTAB Manual § 404.09 (setting forth the "most significant" differences between discovery and testimony depositions, including, for example, that the content of testimony depositions is limited to evidence admissible under applicable rules of evidence; that every testimony deposition must be filed and when filed, becomes part of the record; and that testimony depositions, if not obtained voluntarily, may be taken only pursuant to a subpoena issued by a United States district court); Gary D. Krugman, *Tips From the TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

motion for good cause).[4] These provisions are simply incompatible with VEL's view that foreign trademark applicants can *always* be compelled to give in-person depositions in contested PTO cases, so long as they are subpoenaed in the Eastern District of Virginia. They indicate, to the contrary, that because § 24 authorizes the compulsion of witnesses only in judicial districts where they are "residing or being," foreign companies with de minimis ties to our country are outside the statute's scope because they are not "residing or being" in the United States.

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4. Although my colleagues in the majority are correct that the provisions contained in 37 C.F.R. § 2.120 pertain to discovery depositions, *see ante* at 448 n. 6, they are incorrect that such provisions are unrelated to the PTO's procedures for conducting testimony depositions. While differences between testimony and discovery depositions in fact exist, none of the differences pertain to the question of whether a foreign party may be compelled to provide in-person oral testimony in the United States. *See supra* at 32 n. 3 (citing TTAB § 404.09 "Discovery Depositions Compared to Testimony Depositions"). In fact, the TTAB manual—in setting forth the requirement that testimony depositions, unless "obtained voluntarily," can only be taken pursuant to a subpoena issued by a United States district court—directly references 37 C.F.R. § 2.120(b), which is instructive on the issue of securing the attendance of a natural person for a deposition in the United States. *See* TTAB Manual § 404.09 & n. 114. Moreover, the explicit references in 37 C.F.R. § 2.120 to discovery depositions do not dilute the fact that the PTO took seriously Congress's limitation in 35 U.S.C. § 24 that oral depositions can be taken only from witnesses that "live or reside" in the United States.

In addition, the TTAB has elaborate provisions that allow litigants to take the testimony of foreign adverse parties or other witnesses through mechanisms other than in-person deposition testimony, which would make little sense if such parties could simply be called to give oral deposition testimony in the United States. Litigants may take foreign witnesses' depositions through the letter rogatory procedure and Hague Convention letter of request procedure, *see* TTAB Manual § 703.01(f)(3); *id.* § 404.03(c)(2), and may take depositions upon written questions without regard to a witness's or party's country of origin, *see* 37 C.F.R. § 2.124; *id.* § 2.123. Perhaps most critically, the regulations establish a presumption in favor of written depositions by foreign witnesses in foreign countries over oral depositions abroad. They provide, "A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions . . . unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate." *Id.* § 2.123(2).

It is hard to imagine that the TTAB would have made it so difficult to subpoena foreign parties for oral depositions in their home countries, if it viewed § 24 as permitting parties to require such witnesses to travel to the United States to give such depositions. In sum, like the TTAB Manual and the TTAB ruling in this case, the PTO's framework of regulations suggests that the agency whose expertise in trademark disputes is entitled to respect viewed foreign companies with very limited American contacts as beyond the reach of adverse parties under § 24.

B.

Congress has provided that the PTO "shall be responsible for the granting and issuing of patents and the registration of trademarks" and "may establish regulations, not inconsistent with law" that "shall govern the conduct of proceedings in the Office." 35 U.S.C. § 2 (2000). We have therefore noted that TTAB decisions interpreting the extent of intellectual property protections under the Lanham Act are entitled to "great weight." *Int'l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 378 (4th Cir.2003); *see also In re Dr. Pepper Co.*, 836 F.2d 508, 510 (Fed.Cir.1987) ("While the interpretations of the statute by the board are not binding on this court, under general principles of administrative law, deference should be given by a court to the interpretation by the agency charged with its administration.").

A number of our sister circuits have noted the perils of simply disregarding the PTO's view in construing other aspects of § 24's scope. Those circuits have placed especial emphasis upon § 24's authorization of in-person depositions only when the "testimony *is to be taken for use in any contested case in the Patent and Trademark Office.*" 35 U.S.C. § 24 (emphasis added). The First, Third, and Fifth Circuits have thus held that § 24 authorizes district courts to issue subpoenas for discovery materials only when the PTO's rules also authorized the parties to obtain the materials in question. *See Brown v. Braddick*, 595 F.2d 961, 966 (5th Cir.1979); *Sheehan v. Doyle*, 529 F.2d 38, 39 (1st Cir.1976) (" *Doyle*

II") ; *Sheehan v. Doyle*, 513 F.2d 895 (1st Cir.1975) (" *Doyle I* "); *Frilette v. Kimberlin*, 508 F.2d 205 (3d Cir.1974) (en banc). *But see Natta v. Hogan*, 392 F.2d 686, 690 (10th Cir.1968) (suggesting § 24 authorizes district courts to issue subpoenas without regard to limitations in PTO's rules).

The First Circuit explained based upon § 24's text and structure that the statute "is simply a provision giving teeth, through the courts' subpoena powers, to authority conferred upon the Commissioner of Patents." *Doyle I*, 513 F.2d at 898. It "provided for judicial subpoenas to be used in aid of contested Patent Office cases (including for purposes of broad-based Federal Rules of discovery) but only to the extent permitted by the Commissioner of Patents," who heads the PTO. *Doyle II*, 529 F.2d at 39. "What we rejected," the First Circuit concluded, "was the use of the federal district courts 'as alternative forums of first resort rather than as forums acting strictly in aid of a primary proceeding.' " *Id.* (quoting *Doyle I*, 513 F.2d at 899).

VEL's view suffers the problems identified by the First, Third, and Fifth Circuits. While § 24's authorization of subpoenas only for testimony "to be taken for use in any contested case in the Patent and Trademark Office" led those circuits to reject use of § 24 to obtain evidence the PTO does not authorize, VEL glosses over this limitation entirely. This enables disruptions of PTO proceedings that our sister circuits explained would be incompatible with the statute's design as an aid to PTO proceedings. In particular,

because of the majority's decision, PTO litigants can now routinely seek to stay the agency's proceedings, as VEL has done here, and then go before a district court and get evidence not provided for under the PTO's own rules. *See Frilette*, 508 F.2d at 210. This divorces the subpoena authority from "the rudder that the court or agency which should have control over the case can provide," *id.* at 211, and permits evasion of the PTO's framework for obtaining evidence in its own cases. The majority's disregard for the PTO's ruling in this case, the TTAB Manual, and the structure set forth in PTO regulations not only ignores the expertise of the agency most familiar with the statute before us, but also does violence to the statute's role—established by its text—as an aid to PTO proceedings.

IV.

In concluding without explanation that foreign companies with the most minimal U.S. contacts ought to be subject to compulsory in-person depositions in PTO cases, the majority overlooks the guideposts—including the very statute governing this situation—that should control its decision. It disregards the statutory text limiting such compulsion to entities "residing or being" within a United States judicial district. It ignores numerous canons of construction relevant to the statute's foreign reach. It disregards the evident expert view of the PTO whose proceedings § 24 is intended to aid.

I fear the result is not simply one that Congress did not intend, but one that could in time negatively impact

not only the operations of the PTO, but also international trade and foreign relations. Since a statute that authorizes compulsory depositions only of entities "residing or being" within a judicial district does not clearly reach foreign companies that have done nothing more than file an application for trademark registration, I would heed the Supreme Court's cautionary words: "[f]or us to run interference in such a delicate field of international relations there must be present the affirmative intention of the Congress clearly expressed." *Benz v. Compania Naviera Hidalgo, S.A.*, 353 U.S. 138, 147, 77 S.Ct. 699, 1 L.Ed.2d 709 (1957). The "affirmative intention" of the Congress is affirmatively at odds with the result reached here. I respectfully dissent.

APPENDIX B — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA, ALEXANDRIA DIVISION DATED APRIL 10, 2006

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA

Alexandria Division

Misc. Civil Case No. 06-007

ROSENRUIST-GESTAO E SERVICIOS LDA,

Plaintiff,

v.

VIRGIN ENTERPRISES LIMITED,

Defendant.

ORDER

This matter comes before the Court on Plaintiff's Objections to Memorandum Opinion and Order of Magistrate Judge from March 2, 2006. A district court may overturn or modify a magistrate judge's findings in a nondispositive matter only if it finds that the matter was clearly erroneous or contrary to law. Fed. R. Civ. P. 72(a). The Court finds that the Magistrate Judge's Order from March 2, 2006, was not clearly erroneous or contrary to law. It is hereby

ORDERED that Plaintiff's motion is DENIED.

Appendix B

/s/
CLAUDE M. HILTON
UNITED STATES DISTRICT JUDGE

Alexandria, Virginia
April 10, 2006

APPENDIX C — MEMORANDUM OPINION AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA, ALEXANDRIA DIVISION FILED MARCH 2, 2006

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

CIVIL ACTION NO. 1:06mc7

Rosenruist-Gestao E Servicios LDA,

Plaintiffs,

v.

Virgin Enterprises Limited,

Defendant.

MEMORANDUM OPINION & ORDER

Before the Court is Rosenruist-Gestao Servicios LDA's Motion to Quash Subpoena (Dkt. no. 1), Virgin Enterprises Limited's Opposition to Motion to Quash Subpoena (Dkt. no. 4), Rosenruist-Gestao E Servicios LDA's Reply Brief in Further Support of Motion to Quash Subpoena (Dkt. no. 7), Rosenruist's Supplemental Brief in Support of Motion to Quash Subpoena (Dkt. no. 11) and Virgin Enterprises Limited's Supplemental Brief in Opposition to Motion to Quash Subpoena (Dkt. no.

10). For the reasons set forth herein, Rosenruist-Gestao E Servicios LDA's Motion to Quash Subpoena is hereby **DENIED.**

I. *Procedural History*

The Motion before this Court relates to a trademark opposition proceeding that Virgin Enterprises Limited ("VEL") commenced against Rosenruist-Gestao E Servicios LDA ("Rosenruist") under 15 U.S.C. § 1063 (the "Opposition Proceeding"). (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 1). The Opposition Proceeding is currently pending before the United States Patent and Trademark Office (the "PTO") and is in the 30-day "testimony period" for plaintiff to present its case in chief. (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 1). VEL's testimony period in the Opposition Proceeding opened February 14, 2006 and is scheduled to close March 15, 2006. (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 1). As part of this testimony period, VEL served Rosenruist a subpoena issued by the United States District Court for the Eastern District of Virginia on January 31, 2006 seeking Rosenruist's Rule 30(b)(6) designee. The subpoena was served upon Rosenruist-Gestao E Servicios Sociedade Unipessoal LDA, a corporation organized under the laws of Portugal, 745 South 23rd Street, Arlington, Virginia 22202.

Rosenruist filed the instant Motion to Quash Subpoena on February 14, 2006 (Dkt. no. 1). The matter was heard on February 24, 2006 before United States Magistrate Judge Barry R. Poretz. Judge Poretz found

that the subpoena was facially valid and took the matter under advisement by Order dated February 24, 2006 pending submission by the parties of supplemental briefs addressing the issue of service of the subpoena upon Rosenruist's U.S. Counsel and issuance of this memorandum opinion and order. (Dkt. no. 8).

II. *Factual Background*

In December 2002, Rosenruist, a corporation organized and existing under the laws of Portugal, filed an application at the PTO seeking issuance of a United States registration of Virgin Gorda as a trademark for numerous categories of goods. (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 3). Both in the original application filed with the PTO and in a subsequent amendment dated January 29, 2003, Rosenruist made an "APPOINTMENT OF DOMESTIC REPRESENTATIVE" pursuant to 15 U.S.C. § 1051(e)[1] whereby various individuals with addresses in Arlington, Virginia were formally "designated as applicants'

1. Designation of resident for service of process and notices:

> If the application is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy therof at the address specified in the last designation so filed . . . 15 U.S.C. § 1051(e).

representatives upon whom notices or process in proceedings affecting this mark may be served." (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 3-4). During the prosecution of the trademark application, Rosenruist's United States representatives made a number of factual representations to the PTO. (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 4).

In a first attempt to procure Rosenruist's testimony, VEL on December 12, 2005, filed a motion with the PTO's Trademark Trial and Appeal Board ("TTAB") for an Order compelling Rosenruist to appear for a testimonial deposition by oral examination in its home country of Portugal. (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 4). On January 9, 2006, the TTAB issued an Order explaining that it lacked authority to compel Rosenruist to appear for deposition in Portugal. (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 4).

In a second attempt to procure Rosenruist's testimony, VEL obtained a subpoena from this Court pursuant to 35 U.S.C. § 24 demanding that Rosenruist designate a Rule 30(b)(6) representative to testify in McLean, Virginia with respect to factual representations made in Rosenruist's original trademark application. (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 5). VEL served the subpoena on Rosenruist via one of the United States domestic representatives in Arlington, Virginia that Rosenruist had designated in accordance with 15 U.S.C. 1051(e). (VEL Opp. to Rosenruist Mot. To Strike, Dkt. no. 29, at 5). According to the subpoena's proof of service, the subpoena was personally delivered

to Thomas Perkins, one of the individuals whom Rosenruist expressly appointed its representative for "proceedings affecting the mark." (VEL Opp. to Rosenruist Mot. to Quash, Dkt. no. 4, at 5). Rosenruist subsequently filed the instant Motion to Quash.

III. *Analysis*

Several issues of first impression are implicated by the instant Motion. First, the Court must consider whether the subpoena for the designation of a Rule 30(b)(6) representative was properly issued by this Court in accordance with 35 U.S.C. § 24 and the applicable Federal Rules of Civil Procedure. If the Court finds that the subpoena is valid on its face, the Court must then determine whether service of the subpoena upon Rosenruist's 15 U.S.C. 1051(e) designee is proper service.

The Court, for the reasons discussed below, finds that VEL followed the appropriate procedures outlined in the relevant statutes, thus the subpoena was properly issued by this Court. The Court also finds that service of the subpoena upon Rosenruist's 15 U.S.C. 1051(e) designee was valid.

A. Issuance of the Subpoena

The issuance of a subpoena for cases before the Patent and Trademark Office is governed by 35 U.S.C. § 24 which states:

Appendix C

> The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office . . . 35 U.S.C. 24.

In this instance, the applicable rules of Civil Procedures are Rule 45(a)(2)(B) and Rule 30(b)(6). Rule 45(a)(2)(B) states that a subpoena must issue for attendance at a deposition, from the court for the district where the deposition is to be taken. Fed. R. Civ. Pro. 45(a)(2)(B). Rule 30(b)(6) states, "a party may in the party's notice and in a subpoena name as the deponent a public or private corporation . . . In that event, the organization so named shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf . . ." Fed. R. Civ. Pro. 30(b)(6).

35 U.S.C. § 24 requires that there be a contested case in the Patent and Trademark Office. It is uncontested that Rosenruist and VEL are engaged in a

contested proceeding pending before the United States Patent and Trademark Office, thereby meeting the first element of 35 U.S.C. § 24. (Rosenruist Mot. to Strike, Dkt. no. 1, at 1; VEL Opp. to Mot. to Strike, Dkt. no. 4, at 1).

35 U.S.C. § 24 requires that there be an application by a party for a subpoena for any witness residing or being within such district commanding him to appear and testify before an office in such district authorized to take depositions. VEL, as a party to the action before the PTO, served a subpoena upon Rosenruist seeking its 30(b)(6) designee for the purposes of taking that designee's deposition within this judicial district. (VEL Opp. to Mot. to Strike, Dkt. no. 4, at 1). Rosenruist, a private corporation, may only be deposed through the person it designates to testify on its behalf in accordance with Rule 30(b)(6). Rule 45(a)(2)(B) mandates that a subpoena for a deposition must issue from the Court for the district where the deposition is to be taken.

The subpoena in the instant matters calls for Rosenruist's 30(b)(6) designee's deposition to be taken at an address in McLean, Virginia. McLean, Virginia is located within the jurisdiction of the District Court for the Eastern District of Virginia. It was therefore proper for the District Court for the Eastern District of Virginia to issue the Subpoena for Rosenruist's 30(b)(6) designee and this matter is properly before this Court. Rosenruist does not contest VEL's right to request that it provide a 30(b)(6) designee nor does it appear to be contesting the validity of the Subpoena upon any of the grounds listed

in Rule 45(c)(3)(A) for which a Court shall modify or quash a subpoena.[2]

The Magistrate Judge finds that the subpoena requiring Rosenruist to designate a Rule 30(b)(6) representative was properly issued by the District Court for the Eastern District of Virginia. The Magistrate Judge further finds that the requirements of 35 U.S.C. § 24 have been met and that VEL followed the applicable Federal Rules and procedural guidelines. The subpoena is thus valid on its face. The only remaining question is whether service of the subpoena upon Rosenruist's 15 U.S.C. 1051(e) designee is valid.

B. Service of the Subpoena

Rosenruist argues that service of the subpoena constitutes an abuse of this Court's subpoena powers and should be dismissed because VEL's counsel addressed the subpoena to the U.S. counsel for Rosenruist rather than serving Rosenruist. (Rosenruist Mot. to Strike, Dkt. no. 1, at 3). VEL, on the other hand, argues that serving U.S. Counsel for Rosenruist was appropriate because, pursuant to 15 U.S.C. 1051(e), U.S. Counsel for

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2. On timely motion, the court by which a subpoena was issued shall quash or modify the subpoena if it (i) fails to allow reasonable time for compliance; (ii) requires a person who is not a party or an officer of a party to travel to a place more than 100 miles from the place where that person resides . . . (iii) requires disclosure of privileged or other protected matter and no exception or waiver applies, or (iv) subjects a person to undue burden. Fed. R. Civ. P. 45(a)(2)(B).

Rosenruist was designated as one of Rosenruist's domestic representatives for purposes of receiving notices and process for proceedings affecting the mark. (VEL Opp. to Mot. to Strike, Dkt. no. 4, at 6)

A close look at the language of 15 U.S.C. 1051(e) is instructive. It states:

> If the applicant [for trademark registration] is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed . . . 15 U.S.C. 1051(e).

As the District Court for the Northern District of Illinois noted in *V&S Vin & Spirit Aktiebolag v. Cracovia Brands, Inc.*,

> . . . There is nothing in the text of § 1051(e) itself or in the legislative history which suggests that "proceedings affecting the mark" are limited to proceedings before the PTO. Foreign companies seeking to benefit from the protections of the U.S. trademark

laws must designated an agent to receive service of process, and this extends to civil proceedings. 212 F. Supp. 2d 852, 855-56 (N.D. Ill. 2002).

In *V & S Vin & Spirit,* the Northern District of Illinois was presented with an issue similar to the present one. In that case, Plaintiff V & S Vin & Spirit filed a complaint against Przedsiebiorstwo Polmos Bialystok, S.A. ("PPB"), a Polish corporation, alleging, among other things, trademark infringement based on PPB's application for a federal registration. *Id.* at 853. V & S timely served its complaint and summons on PPB's law firm, which was its § 1051(e) appointed agent for service of process in connection with its trademark application before the PTO. *Id.*

The Court noted that, contrary to PPB's assertion, the Hague Convention does not constitute the exclusive means for effecting service on a foreign national where internal law provides for an alternative mode of service. *Id.* at 254. "Where service on a domestic agent is valid and complete under both state law and the Due Process Clause, the inquiry ends and the Convention has no further implications." *Id.* (*Citing Volkswagenwerk Aktiengesellschaft v. Schlunck,* 486 U.S. 694 (1988)). Accordingly, the Court held that PPB's designated agent pursuant to § 1051(e) was authorized to receive service of process on behalf of PPB and PPB's Motion to Quash Service was denied. *Id.* at 856.

V & S Vin & Spirit involved service of the 1051(e) representative in commencing a separate trademark infringement action in federal court. VEL, however, presents a stronger basis for proper service, as it served the subpoena as part of its opposition proceeding before the PTO. The instant Motion to Quash is not a separate lawsuit but merely ancillary to the PTO trademark opposition proceeding. Rosenruist named U.S. Counsel as its domestic representative for notice and process for proceedings affecting the mark. The subpoena at issue arises as part of the PTO proceedings concerning the original mark. The Magistrate Judge finds that Rosenruist was properly served via its § 1051(e) designee with the subpoena.

IV. *Order*

For the reasons set forth in this memorandum, it is **ORDERED** that Rosenruist's Motion to Quash Subpoena (Dkt. no. 1) is hereby **DENIED.** Rosenruist is hereby **ORDERED** to designate a Rule 30(b)(6) witness residing or being within this judicial district to appear for deposition by March 15, 2006.

The Clerk is **DIRECTED** to forward copies of this Memorandum Opinion and Order to the Parties.

Entered this 2nd day, March 2006.

Appendix C

s/ Barry R. Poretz
Barry R. Poretz
United States Magistrate Judge

Alexandria, Virginia

APPENDIX D — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA, ALEXANDRIA DIVISION DATED MAY 1, 2006

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA

Alexandria Division

Misc. Civil Action No. 06-0007

ROSENRUIST-GESTAO E SERVICIOS LDA,

Plaintiff,

v.

VIRGIN ENTERPRISES LIMITED,

Defendant.

ORDER

This matter comes before the Court on Defendant's Objections to Magistrate Judge's Order Omitting Awarded Attorneys Fees and Objections to Magistrate Judge's Order. It appearing to the Court that Magistrate Judge Poretz's Orders of April 6, 2006, and April 10, 2006, are not clearly erroneous or contrary to law, it is hereby

ORDERED that Defendant's Objections to Magistrate Judge's Order Omitting Awarded Attorneys Fees and Objections to Magistrate Judge's Order are DENIED.

Appendix D

/s/
CLAUDE M. HILTON
UNITED STATES DISTRICT JUDGE

Alexandria, Virginia
May 1, 2006

APPENDIX E — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA, ALEXANDRIA DIVISION FILED APRIL 7, 2006

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA ALEXANDRIA DIVISION

Civil Action No.: 1:06mc7

Rosenruist-Gestao E Servicios LDA,

Plaintiff,

v.

Virgin Enterprises Limited,

Defendant.

ORDER

Before the Court is Virgin Enterprises Limited's Motion to Compel Rule 30(b)(6) Designation and Appearance (Dkt. no. 26), Rosenruist-Gestao E Servicios LDA's Response in Opposition (Dkt. no. 30), and Virgin Enterprises Limited's Reply Memorandum in Support to the Motion to Compel (Dkt. no. 31). In accordance with the specific rulings stated from the bench, it is hereby

Appendix E

ORDERED,

Virgin Enterprises Limited's Motion to Compel Rule 30(b)(6) Designation and Appearance (Dkt. no. 26) is hereby **GRANTED IN PART AND DENIED IN PART.**

Entered this 7th day of April 2006

s/ Barry R. Poretz
Barry R. Poretz
United States Magistrate Judge

Alexandria, Virginia

APPENDIX F — EXCERPT OF HEARING ON MOTIONS OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA, ALEXANDRIA DIVISION DATED APRIL 7, 2006

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
Alexandria Division

Case No. 1:06-MC7

ROSENRUIST-GESTAO E SERVICIOS LDA,

Plaintiff,

-vs-

VIRGIN ENTERPRISES LIMITED,

Defendant.

HEARINGS ON MOTIONS

April 7, 2006

Before: Barry R. Poretz, Magistrate Judge

* * *

THE COURT: So, there — I have — And I didn't mean to cut everybody off on the arguments, but I am familiar with the issues.

Appendix F

Procedurally, this is before the Court today on Virgin Enterprises' motion to compel a 30(b)(6) designation and appearance.

My order probably will reflect, I have got to think about it, that it is granted in part, denied in part. It is granted to the extent that Rosenruist must by next Friday submit a declaration along the lines that I indicated; that is, a motion to compel the designation. They may not like your response, I understand that.

I am not at this time — I am denying in part because I am not requiring an appearance at this time. And we will take it step by step. I don't know what else to do at this time. I don't know what else to do. I think that just puts everybody on terms. And I know Virgin disagrees with the Court's ruling as to witness within or residing, but that's my ruling.

MR. RIGLER: Okay.

THE COURT: That's my ruling, Anything else from good counsel?

* * * *

APPENDIX G — ORDER OF THE UNITED STATES PATENT AND TRADEMARK OFFICE MAILED JANUARY 9, 2006

UNITED STATES PATENT AND
TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: January 9, 2006

Opposition No. 91161535

Virgin Enterprises Limited

v.

Rosenquist – Gestao E Servicios
Sociedade Unipessoal Lda

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

Discovery closed February 15, 2005. In accordance with opposer's consented request, the ESTTA filing system entered a suspension of proceedings until January 4, 2006 to accommodate settlement discussions, with the right of either party to request resumption at any time, and set automatic resumption dates.

On December 12, 2005, opposer moved to compel applicant to appear for an oral testimonial deposition. Applicant, on January 3, 2005, moved to strike opposer's

motion as untimely inasmuch as the proceedings were in a suspended status. Applicant alternatively asks for an extension of time to respond to opposer's motion.

Applicant's motion to strike opposer's motion to compel is denied. Opposer's motion to compel is interpreted as its request to resume; and Trademark Rule 2.127(a) sets the time to respond to motions. Thus, there is no need for the Board to issue a separate order. For reasons that will become clear, *infra*, applicant's alternative request to extend its time to respond to opposer's motion to compel is moot.

Opposer, by its motion, seeks an order compelling applicant to appear for a testimonial deposition by oral examination in applicant's home country of Portugal.

A testimony deposition is a device used by a party to present evidence in support of its case. Such depositions are taken by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying in behalf of the party. In the United States, such depositions may be taken on notice alone or, where the adverse party or third party witness is unwilling, by subpoena issued by a United States district court. *See* TBMP §§703.01(a), 703.01(f)(1); and 703.01(f)(2) (2d ed. rev. 2004). However, where the adverse party or unwilling witness resides in a foreign country, the party seeking to take the testimonial deposition of such witness may not be able to do so absent the letter rogatory procedure or The Hague Convention

letter of request procedure. *Id.* §703.01(f)(3). *See also Jain v. Ramparts, Inc.*, 49 USPQ2d 1429 (TTAB 1998). The case referenced by opposer, *Orion Group, Inc. v. Orion Ins. Co.*, 12 USPQ2d 1923 (TTAB 1989), is distinguishable because it involved a discovery deposition (more specifically a discovery deposition pursuant to Fed. R. Civ. P. 56(f)).

Accordingly, opposer's motion to compel applicant to appear at an oral testimonial deposition in applicant's home country is denied.

Proceedings are resumed and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	**CLOSED**
30-day testimony period for party in position of plaintiff to close:	March 15, 2006
30-day testimony period for party in position of defendant to close:	May 14, 2006
15-day rebuttal testimony period to close:	June 28, 2006

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Appendix G

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

No. 07-1214

FILED
APR 23 2008
OFFICE OF THE CLERK
SUPREME COURT, U.S.

IN THE

Supreme Court of the United States

ROSENRUIST-GESTAO E SERVICOS LDA,

Petitioner,

—against—

VIRGIN ENTERPRISES LIMITED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Petitioner is the applicant party in a trademark opposition case entitled *Virgin Enterprises Ltd. v. Rosenruist-Gestao E Servicos Sociedade Unipessoal LDA*, No. 91161535, which is currently pending before the United States Trademark Trial and Appeal Board of the United States Patent and Trademark Office (the "Opposition Case"). In the proceedings below, the Petitioner was served with a subpoena in Arlington, Virginia and commanded to appear for a trial testimony deposition in the Opposition Case, but Petitioner refused to appear for deposition even though (i) Petitioner is making the claim whose validity is the subject of the Opposition Case, and (ii) Petitioner has appeared in, taken discovery in, filed motions in, opposed summary judgment in, and extensively cross-examined Respondent's witnesses at the trial of the Opposition Case.

The question presented is: whether the Fourth Circuit correctly held, in the particular and unusual circumstances of this case, that the district court "should have granted VEL's motion to compel" (Pet. App. 14a) and ordered this Petitioner to appear for a trial testimony deposition in the Opposition Case.

CORPORATE DISCLOSURE STATEMENT

Respondent ("VEL") is an indirect wholly-owned subsidiary of Virgin Group Holdings Limited, a corporation existing under the laws of The British Virgin Islands.

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STATEMENT OF THE CASE

This case relates to a trademark opposition case entitled *Virgin Enterprises Ltd. v. Rosenruist-Gestao E Servicos Sociedade Unipessoal LDA*, No. 91161535 (the "Opposition Case"), which is currently pending before the United States Trademark Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office (the "PTO"). The events that gave rise to the Opposition Case are accurately described in the Fourth Circuit opinion below (Pet. App. 2a-5a) and are summarized briefly here.

The Petitioner's Application

On or about December 30, 2002, the Petitioner, acting through representatives located in Arlington, Virginia, transmitted to the PTO in Alexandria, Virginia, a written application for issuance of a United States registration of VIRGIN GORDA as a trademark purportedly owned by Petitioner (the "Application"; *see* C.A. App. 46-48). The Application was subsequently assigned Serial No. 76/479620 by the PTO. *Id.*

In its Application, the Petitioner claimed that it was entitled to exclude Respondent and all others from using VIRGIN GORDA, or any mark that was confusingly similar to VIRGIN GORDA, on or in connection with numerous and diverse categories of goods ranging from "umbrellas" to "trunks" to "bomber jackets" to "shoes" (C.A. App. 46-48). The basis of the Petitioner's claim was a sworn (and highly implausible) statement that Petitioner purportedly had a "bona fide intention to use the mark in commerce" (15 U.S.C. § 1051(b)(3)(B)) on or in

connection with each and every one of the numerous and diverse categories of goods that were listed in the Application. *Id.*[1]

By filing the Application and furnishing the PTO with a sworn declaration of "bona fide intention to use the mark in commerce," 15 U.S.C. § 1051(b)(3)(B), the Petitioner purposefully availed itself of various benefits of United States federal trademark law, including the provisional "right of priority, nationwide in effect," that flows from the filing of a properly supported application for trademark registration, 15 U.S.C. § 1057(c), and the various procedural and substantive rights that United States federal trademark law confers on applicants for registration in adversarial proceedings that test the merits of claimed rights to registration, including opposition proceedings commenced under 15 U.S.C. § 1063.

Petitioner Appoints Representatives and Submits to Jurisdiction in the United States

As part of its Application, the Petitioner granted broad powers of attorney to various individuals with addresses in Arlington, Virginia, who were author-

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[1] The implausibility that Petitioner could have had the claimed "bona fide intention to use the mark in commerce" (15 U.S.C. § 1051(b)(3)(B)) on each and every one of the numerous and diverse categories of goods that were listed in the Application, *cf. Medinol Ltd. v. Neuro Vasx Inc.*, 67 U.S.P.Q.2d 1205 (T.T.A.B. 2003) (canceling registration where applicant falsely claimed use of mark to identify all goods listed in application), would appear to explain the Petitioner's relentless and costly efforts to seek to evade giving any deposition upon oral examination in the Opposition Case.

ized by Petitioner "to prosecute this application for registration, with full power of substitution and revocation, to transact all business in the United States Patent and Trademark Office in connection therewith, and to receive the Certificate of Registration" (C.A. App. 47). Those same individuals were expressly "designated Applicant's representative[s] upon whom notices or process in proceedings affecting this mark may be served." *Id.*

The Petitioner's designation of persons resident in the United States "upon whom notices and process in proceedings affecting this mark may be served" (C.A. App. 47, 52) was made in fulfillment of a legal requirement that 15 U.S.C. § 1051(e) has long imposed on alien applicants for registration of United States trademarks and service marks. The statute ensures that in the event that an alien's claim of right to registration is contested, there is at least one court of the United States where the alien applicant is subject to jurisdiction and can be compelled to make discovery and otherwise justify its claim.[2]

Had Petitioner failed to designate a person resident in the United States upon whom process could be served in proceedings affecting the applied-for mark, the Petitioner would have been automatically

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[2] *Cf. Mississippi Pub. Corp. v. Murphree*, 326 U.S. 438, 442 (1946) ("By consenting to service of process upon its agent residing in the southern district, petitioner rendered itself 'present' there for purposes of service"); *Neirbo v. Bethlehem Shipbuilding Corp.*, 308 U.S. 165, 175 (1939) (by designating an agent for service of process in a state, the respondent gave "actual consent" to being sued in the courts of the state, federal as well as state).

deemed, by statute, to have appointed the Director of the PTO as Petitioner's agent for service of process in proceedings affecting the applied-for mark. *See* 15 U.S.C. § 1051(e).

Petitioner Prosecutes the Application Through United States Representatives

In a communication dated July 23, 2003, and addressed to one of Petitioner's Virginia-based representatives, the PTO initially rejected the Petitioner's claim of right to registration of VIRGIN GORDA on the basis that the proposed mark appeared to be primarily geographically misdescriptive of the origin of the goods that Petitioner had listed in the Application, and further, that the Petitioner's claim of intent to use VIRGIN GORDA on "bags" was impermissibly indefinite (C.A. App. 56-59). Petitioner responded to the PTO's rejection through its Virginia-based representatives (C.A. App. 61-69).

On the issue of what particular types of "bags" Petitioner allegedly intended to distribute in United States commerce under the mark VIRGIN GORDA, Petitioner's Virginia-based representatives amended the Application so that it recited, as the "goods" on which Petitioner purportedly had a "bona fide intention to use the mark in commerce," the following: "all-purpose athletic bags, beach bags, book bags, carry-on bags, gym bags, leather shopping bags, overnight bags, shoulder bags, tote bags and cosmetic bags sold empty; purses, coin-purses, pocket wallets, traveling bags, trunks, make-up bags, empty vanity cases, briefcases, umbrellas, handbags" (C.A. App. 62). "This amendment," Petitioner told the PTO through its Virginia-based representatives,

purportedly "clarifie[d] the identification of goods to reflect the true nature and character of the goods provided in connection with the VIRGIN GORDA mark." *Id.*

On the issue of whether VIRGIN GORDA was primarily geographically misdescriptive of the originally named and newly added goods recited in the Application, Petitioner's Virginia-based representatives asserted to the PTO that "most Americans" would not be "aware" of a "remote island" named "Virgin Gorda" (C.A. App. 64). Petitioner's Virginia-based representatives further asserted to the PTO: "The island of Virgin Gorda is not known for producing the goods identified in this application" (C.A. App. 63). Finally, Petitioner's Virginia-based representatives asserted that some unspecified number of United States consumers of the listed goods were Spanish-speaking and so would understand that the word "gorda" meant "fat" in Spanish (C.A. App. 64).

Based on Petitioner's various factual assertions as described above, the PTO was persuaded to withdraw its rejection of the Application (C.A. App. 67-68) and to publish the Application for opposition in the Official Gazette of the PTO, which publication occurred June 1, 2004 (C.A. App. 70). On July 29, 2004, Respondent timely filed a Notice of Opposition under 15 U.S.C. § 1063 (C.A. App. 72-78). The PTO then instituted the Opposition Case entitled *Virgin Enterprises Ltd. v. Rosenruist-Gestao E Servicos Sociedade Unipessoal LDA*, No. 91161535 (T.T.A.B., filed Jul. 29, 2004). *See* C.A. App. 86-87.

In the thirteen (13) months between July 2004 and August 2005, the Petitioner (i) served an An-

swer in the Opposition Case, (ii) took discovery in the Opposition Case, (iii) moved to compel further discovery in the Opposition Case, and (iv) successfully opposed a motion for summary judgment in the Opposition Case (C.A. App. 833-34). By Order dated January 9, 2006, the TTAB set the Opposition Case for trial[3] to begin February 14, 2006. *Id.*

Petitioner Refuses to Appear Voluntarily for Deposition in Its Home Country of Portugal

In anticipation of the commencement of trial in the Opposition Case, Respondent requested that Petitioner voluntarily appear for a trial testimony deposition on oral examination in its home country of Portugal (C.A. App. 43). Petitioner refused (*id.*). Petitioner took the position that if Respondent wanted to cross-examine Petitioner by oral deposition, Respondent would have to (i) seek issuance of letters rogatory addressed to some Portuguese legal authority, and then (ii) hope that the Portuguese legal authority, applying Portuguese law, might be

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[3] Under TTAB rules, "[t]he assignment of testimony periods corresponds to the setting a case for trial in court proceedings," and "[t]he taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings." 37 C.F.R. § 2.116(d)-(e). The "trial testimony" of witnesses in opposition proceedings is taken by depositions under 37 C.F.R. § 2.123. Respondent's original "trial testimony period" in the Opposition Case ran from February 14 through March 15, 2006. The TTAB has since suspended proceedings in the Opposition Case so as to afford Respondent an opportunity to seek compelled deposition testimony from the Petitioner. *See* TTAB Order dated August 7, 2006, and reproduced in the Appendix to this Brief in Opposition.

persuaded to order Petitioner to appear for deposition upon oral examination in Portugal.

On December 12, 2005, Respondent moved the TTAB for an Order compelling Petitioner to appear for a testimonial deposition by oral examination in its home country (C.A. App. 99-134). On January 9, 2006, the TTAB issued an Order (C.A. App. 136-138) explaining that it lacked authority to compel recalcitrant parties to appear for deposition in any jurisdiction, foreign or domestic; however, the TTAB noted that a recalcitrant party to an opposition proceeding could be compelled to attend a deposition in the United States "by subpoena issued by a United States district court" (C.A. App. 137). That was the course that Respondent then took.

Petitioner Is Subpoenaed to Appear for Deposition in the United States

On January 31, 2006, Respondent served one of Petitioner's designated domestic representatives in Arlington, Virginia with a deposition subpoena issued under 35 U.S.C. § 24 (C.A. App. 140-142). The subpoena was addressed to Petitioner, the corporation, as authorized by Federal Rule of Civil Procedure 30(b)(6), which provides in pertinent part:

> A party may in the party's notice and in a subpoena name as the deponent a public or private corporation or a partnership or association or governmental agency and describe with a reasonable particularity the matters on which examination is requested. In that event, the organization so named shall designate one or more officers, directors, or manag-

> ing agents, or other persons who consent to testify on its behalf and may set forth for each person designated the matters on which the person will testify. A subpoena shall advise a non-party organization of its duty to make such a designation. The person so designated shall testify as to matters known or reasonably available to the organization.

The subpoena commanded Petitioner to appear at a location in McClean, Virginia, "to testify at the taking of a deposition in the above case by a person having most knowledge of the matters set forth in Schedule A" to the subpoena (C.A. App. 140). Schedule A of the subpoena identified the following matters on which examination of Petitioner was requested (C.A. App. 142):

1. The factual representations made in United States Application No. 76/479620 filed December 30, 2002 (the "Application").

2. The extent to which United States purchasers of the goods identified in the Application are aware of an island named "Virgin Gorda."

3. The extent to which United States purchasers of the goods identified in the Application are aware of the Spanish language meaning of the word "gorda."

Petitioner's Motion to Quash

On February 8, 2006, Petitioner filed a paper in the district court styled "MOTION OF ROSENRUIST-GESTAO E SERVICOS LDA TO QUASH SUB-

POENA" (C.A. App. 8-27). Petitioner argued that the district court should issue an Order quashing the subpoena on the basis that (i) service of the subpoena on Petitioner's domestic representative under 15 U.S.C. § 1051(e) purportedly was not valid service on Petitioner; (ii) the subpoena was accompanied by only the statutory witness attendance fee of $75.00; and (iii) enforcement of the subpoena purportedly would "violate the sovereignty of another nation" (C.A. App. 9-10). Petitioner additionally sought monetary sanctions against Respondent (C.A. App. 11).

Importantly, the Petitioner did not advance or support any ground for quashing the subpoena that was available to Petitioner under Federal Rule of Civil Procedure 45(c)(3)(A). *See* C.A. App. 183 ("nor does it appear to be contesting the validity of the Subpoena upon any of the grounds listed in Rule 45(c)(3)(A) for which a Court shall modify or quash a subpoena"). The Petitioner also did not offer to appear voluntarily for deposition in any location, at any time, or under any proposed terms or conditions.[4]

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[4] It is difficult to overstate just how unusual Petitioner's posture in this case is. Ordinarily, when a party or deponent objects to the location of a deposition and proposes that it be taken in a foreign country, the objecting party bears the burden of demonstrating that the foreign location is both available and more convenient than the noticed location. *E.g., Triple Crown Am. Inc. v. Biosynth AG*, 1998 U.S. Dist. LEXIS 6117, at *10 (E.D. Pa. Apr. 30, 1998); *Doster v. Carl Schenk A.G.*, 141 F.R.D. 50, 51-52 (M.D.N.C. 1991). Here, the Petitioner did not even attempt to demonstrate that Portugal was a more convenient or appropriate locale for its deposition, for as noted above, the Pe-

On March 2, 2006, a Magistrate Judge issued an Order denying Petitioner's motion to quash in its entirety (C.A. App. 178-186.) The Magistrate Judge's Order stated in part: "VEL followed the appropriate procedures outlined in the relevant statutes, thus the subpoena was properly issued by this Court. The Court also finds that the service of the subpoena on Rosenruist's 15 U.S.C. 1051(e) designee was valid. . . . For the reasons set forth in this memorandum, it is ORDERED that Rosenruist's Motion to Quash Subpoena (Dkt. No.1) is hereby DENIED." C.A. App. 181-83.

On March 9, 2006, Petitioner filed objections to the above-quoted Order of the Magistrate Judge pursuant to Federal Rule of Civil Procedure 72(a) (C.A. App. 187-189). On April 10, 2006, the district court denied Petitioner's Rule 72(a) objections in all respects (C.A. App. 412). Petitioner took no appeal from the district court's denial of its motion to quash the subpoena at issue in this case.

Petitioner Is Sanctioned for Failing to Attend Its Own Deposition

Following the Magistrate Judge's denial of Petitioner's motion to quash the subpoena, Respondent re-noticed Petitioner's deposition for March 10, 2006 (*see* C.A. App. 250-252). Approximately five minutes

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titioner had previously refused Respondent's suggestion that Petitioner appear voluntarily for deposition in its home country (C.A. App. 43). The Petitioner's manifest objective below was to attempt to evade giving an oral deposition anywhere, under any circumstances, even while pressing its claimed right to registration of VIRGIN GORDA in the United States.

before the deposition was to begin, one of Petitioner's United States representatives appeared at the deposition location and announced for the first time that Rosenruist was once again refusing to appear or to produce any person to testify on its behalf (C.A. App. 236).

Respondent then moved for monetary sanctions against Petitioner under Federal Rules of Civil Procedure 37(b) and (d) and 45(e), which motion was granted by Order issued April 6, 2006 (C.A. App. 379). The Magistrate Judge ruled at that time (id.):

> Virgin Enterprises Limited's Motion for Sanctions (Dkt. no. 18) is hereby **GRANTED**. The Court finds that the award of attorney's fees and costs are appropriate for Rosenruist-Gestao E Servicos LDA's failure to appear for a properly noticed deposition and failure to inform Virgin Enterprises Limited that it would not appear at the deposition prior to the deposition date.

The district court subsequently denied Petitioner's objections to the order awarding sanctions (C.A. App. 844). Petitioner took no appeal from the district court's order awarding sanctions.

Respondent's Motion to Compel

On March 31, 2006, Respondent moved the district court for an Order compelling Petitioner to appear for deposition under pain of contempt sanctions (C.A. App. 344-352). It is this motion whose disposition gave rise to the Fourth Circuit decision below, and whose merits the Petitioner now asks this Court to review.

Following an oral hearing held April 7, 2006, a Magistrate Judge issued an Order that Respondent's motion to compel was **"GRANTED IN PART AND DENIED IN PART"** based on "the specific rulings stated from the bench" (C.A. App. 381). The Magistrate Judge adhered to his prior ruling (C.A. App. 178-186) that Petitioner had been properly been served in Arlington, Virginia with a subpoena issued under 35 U.S.C. § 24 and was properly commanded to appear for a trial testimony deposition in the Opposition Case.

Respondent's motion was granted only "in part," however, because the Magistrate Judge ruled that the word "witness," as used in the first sentence of 35 U.S.C. § 24, did not refer to the person *named* in a subpoena invoking Federal Rule of Civil Procedure 30(b)(6), but rather supposedly referred to an individual that a subpoenaed corporation might *designate* to testify on its behalf under Rule 30(b)(6). The Magistrate Judge stated, "I think the witness has to live or reside in this district. *I don't think the corporation is the witness. . . The witness, the witness, not the corporation*, must reside or live in this district" (C.A. App. 393; emphasis added).

Based on this extremely narrow and erroneous interpretation of the statutory term "witness" (which all three members of the Fourth Circuit panel below rejected, *see* Pet. App. 17a-18a, 27a), the Magistrate Judge ruled that Petitioner was required to appear for deposition only if, and to the extent that, its preferred or chosen designees personally "reside[d]" or "live[d]" in the district where Petitioner was served with the subpoena in question. The Magistrate

Judge accordingly directed Petitioner either to appear for deposition or else file a declaration to the effect that Petitioner could not locate any individual who both personally "resided or lived" in the Eastern District of Virginia and who "consented" to testify on Petitioner's behalf in the Opposition Case (C.A. App. 393).

Petitioner quickly took advantage of the Magistrate Judge's error. On April 14, 2006, Petitioner filed a paper with the district court in which Petitioner stated that none of its knowledgeable agents "consent[ed]" to testify on Petitioner's behalf in the Eastern District of Virginia (C.A. App. 414). The Petitioner filed this paper even though just one month previously, the Petitioner through counsel had "attended and participated fully in the testimonial depositions of various VEL officers" (Pet. App. 9a n.3), and had filed multiple motions with the TTAB seeking orders (i) reopening discovery, (ii) imposing sanctions on Respondent, and (iii) striking certain trial testimony proffered by Respondent (C.A. App. 833-34). *See* the Appendix to this Brief.

Respondent timely objected (C.A. App. 428-834) to the Magistrate Judge's April 7 ruling under Fed. R. Civ. P. 72(a). On May 2, 2006, the district court entered a one-page Order stating that the Magistrate Judge's order was not "clearly erroneous or contrary to law" (C.A. App. 840).

Respondent's Appeal to the Fourth Circuit

On May 10, 2006, Respondent timely appealed to the Fourth Circuit (C.A. App. 841) from the district court's order entered May 2, 2006, which had

granted-in-part and denied-in-part Respondent's motion to compel filed March 31, 2006. In its appeal to the Fourth Circuit, Respondent raised the questions (i) whether the term "witness," as used in 35 U.S.C. § 24, includes a private corporation that is named in a subpoena as authorized by Federal Rule of Civil Procedure 30(b)(6); (ii) whether a deposition subpoena issued to a corporation under 35 U.S.C.§ 24 and Federal Rule of Civil Procedure 30(b)(6) may properly command the corporation to appear and give testimony by individuals who do not personally "reside or live" in the district where the corporation has been served and commanded to appear; and (iii) whether the district court committed legal error in holding that it lacked statutory authority to enforce the terms of the deposition subpoena at issue in this case. Resp. C.A. Br. at 6.

Lacking any basis for defending the district court's order entered May 2, 2006, the Petitioner's brief to the Fourth Circuit attempted to renew its original, and manifestly frivolous, arguments (e.g., "It is a recognized principal of international law that non-resident aliens may not be compelled to appear in a foreign district to give deposition testimony"; Resp. C.A. Br. at 21) for why service of a subpoena on Petitioner's statutory agent for service of process in the United States was purportedly ineffective to require Petitioner to do anything at all. Petitioner did not, however, file any notice of cross-appeal that would have permitted it to raise these arguments.

The Fourth Circuit's Decision

On December 27, 2007, the Fourth Circuit reversed the District Court's judgment and remanded

for further proceedings. All three members of the panel rejected the district court's ruling that corporations were excluded from the meaning of the term "witness" as used in 35 U.S.C. § 24. The Fourth Circuit panel unanimously concluded that 35 U.S.C. § 24 authorized issuance of subpoenas to corporate deponents under Rule 30(b)(6) of the Federal Rules of Civil Procedure, and that the personal residence of a subpoenaed corporation's chosen or preferred designees was extraneous and irrelevant to the scope of a district court's subpoena power over the subpoenaed corporation itself. *See* Pet. App. 17a-18a, 27a.

Having resolved the issues raised by Respondent's appeal, the Fourth Circuit declined to consider the Petitioner's various arguments for why service of the subpoena on Petitioner's domestic representative under 15 U.S.C. § 1051(e) purportedly was ineffective to require the Petitioner to do anything at all. The Fourth Circuit held that by failing to file a cross-appeal, the Petitioner waived any right it might have had to argue that it was wholly outside the district court's subpoena power on jurisdictional or other grounds (Pet. App. 19a-21a).

The Fourth Circuit further noted that, had Petitioner preserved the issue, the court would have concluded that the Petitioner was a person "being within" the Eastern District of Virginia for purposes of 35 U.S.C. § 24 (Pet. App. 20a n.5) and thus was subject to being subpoenaed "in proceedings affecting the mark" as expressly authorized and contemplated by 15 U.S.C. § 1051(e). In view of the various protections afforded to subpoenaed persons by Federal Rule of Civil Procedure 45(c)(3)(A), the Fourth Cir-

cuit majority found it unnecessary and inappropriate to manipulate the statutory term "being" (35 U.S.C. § 24) as a basis for regulating the exercise of district courts' undoubted authority over corporate litigants like this Petitioner.

REASONS FOR DENYING THE PETITION

In the more than 100 years of trademark opposition practice in the United States, during which time literally millions of applications for registration have been published for opposition, this appears to be the first case, ever, in which an applicant for registration has attempted to take the position that it can refuse to submit to cross-examination with respect to the purported factual basis of its own claim. If the Fourth Circuit here did something "[f]or the first time" (Pet. at 7) or considered an "issue of apparent first impression" (Pet. at 17), that is merely a sign of just how unusual this Petitioner's litigation conduct has been.

The Petition for Writ of Certiorari should be denied, because (i) the questions purportedly presented by the Petition are procedurally defaulted; (ii) the questions purportedly presented by the Petition are, in fact, hypothetical questions whose resolution would be irrelevant to the outcome of this case; (iii) the questions purportedly presented by the Petition involve, at most, the correctness of the Fourth Circuit's application of well-settled law to Petitioner's wishful mischaracterization of the facts of this case; (iv) the decision below does not conflict with that of any other circuit; and (v) the decision below is clearly correct.

I. PETITIONER'S FAILURE TO CROSS-APPEAL BARS CONSIDERATION OF THE QUESTIONS "PRESENTED."

In orders dated March 2, 2006 (C.A. App. 178-86), April 6, 2006 (C.A. App. 379), and April 12, 2006 (C.A. App. 412), the district court denied Petitioner's motion to quash the subpoena and awarded monetary sanctions in favor of Respondent and against Petitioner. The district court's subsequent order entered May 2, 2006 (C.A. App. 840), from which Respondent alone appealed, presupposed the validity of the subpoena and addressed only the narrow question of whether a subpoenaed corporation's obligations under 35 U.S.C. § 24 and Federal Rules of Civil Procedure 30(b)(6) were limited to producing one or more "natural" persons who personally "live[d]" or "reside[d]" in the district where the corporation was served with process and commanded to appear.

In these circumstances, the Fourth Circuit was clearly correct in holding (Pet. App. 19a-21a) that Petitioner's failure to file a cross-appeal bars consideration of Petitioner's attack on the district court's underlying authority and jurisdiction to command Petitioner to do anything at all. Although an appellee may "urge in support of a decree any matter appearing in the record," *El Paso Natural Gas Co. v. Neztsosie*, 526 U.S. 473, 479 (1999), an appellee may not, absent a cross-appeal, challenge a lower court's authority to render a judgment that is partially adverse to the appellee. *See Northwest Airlines, Inc. v. County of Kent, Michigan*, 510 U.S. 355, 365-66 (1994). Stated otherwise, absent a cross-appeal, an appellee may not seek an appellate judgment

"enlarging" the appellee's rights beyond what a District Court awarded, *El Paso*, 526 U.S. at 479 (quoting *United States v. American Ry. Express Co.*, 265 U.S. 425, 435 (1924)), or granting "a new measure of relief." *Morley Constr. Co. v. Maryland Cas. Co.*, 300 U.S. 185, 193 (1937).

The Fourth Circuit properly applied these principles here. This Court's decision in *Northwest* is particularly instructive. In that case, a group of airlines had sued an airport for relief from alleged violations of the federal Anti-Head Tax Act (AHTA). The district court held that there was a private right of action for alleged violations of AHTA, but that the defendant airport had not, in fact, violated the AHTA. The Sixth Circuit similarly held that there was a private right of action for alleged violations of the AHTA, but vacated the district court's judgment insofar as it had upheld the defendant airport's allocation of the costs of providing "crash, fire, and rescue (CFR) services." 510 U.S. at 362. The plaintiffs then petitioned this Court for review of the Sixth Circuit's judgment. The respondent airport did not file any cross-petition, but nevertheless attempted to argue that the petitioning airlines' claims should be rejected altogether on the basis that there was no private right of action for alleged violations of the AHTA and the district court, thus, assertedly lacked authority to grant any relief to the *Northwest* petitioners at all. This Court declined to consider the respondent airport's argument, saying:

> A prevailing party need not cross-petition to defend a judgment on any ground properly raised below, so long as that party seeks to

> preserve, and not to change, the judgment. . . . A cross-petition is required, however, when the respondent seeks to alter the judgment below. . . . Alteration would be in order if the private right of action question were resolved in favor of the Airport. For then, the entire judgment would be undone, including the portion remanding for reallocation of CFR costs between the Airlines and general aviation. The Airport's failure to file a cross-petition on the CFR issue—the issue on which it was a judgment *loser*—thus leads us to resist the plea to declare the AHTA claim unfit for District Court adjudication.

Northwest, 510 U.S. at 364-65.

Both the reasoning and the holding of this Court's *Northwest* decision are directly applicable here. Similarly to how the district court in *Northwest* held that there was a private right of action for alleged violations of the AHTA, the district court here held that this Petitioner was subject to its jurisdiction and was properly served with a subpoena issued under 35 U.S.C. § 24. Similarly to how the airport in *Northwest* attempted to question the district court's authority to grant any relief whatsoever to the complainant airlines, the Petitioner here seeks to challenge the authority of the district court to have commanded the Petitioner to do anything at all in this case.

Having failed to file a cross-appeal to the Fourth Circuit, the Petitioner was barred from arguing to that court (Pet. App. 19a-21a), and is similarly barred from attempting to argue in this Court, that

the district court supposedly lacked jurisdiction over the person of Petitioner or was otherwise without authority to award sanctions or any other relief against Petitioner. This Court in *Northwest* declined to consider, absent a cross-appeal, a challenge to the authority of a court to award relief to a partial judgment loser. It should do the same here and deny the Petition.

II. THE QUESTIONS "PRESENTED" ARE NOT, IN FACT, PRESENTED BY THIS CASE.

Even assuming, for purposes of argument, that the Petitioner could properly ask this Court to review the questions that the Petition purports to present, those questions would not warrant this Court's review because they are hypothetical questions whose resolution would be irrelevant to the outcome of this case.

Contrary to Petitioner's suggestion, this case is not one in which a corporation served with a subpoena had "no contact with the United States other than the filing of a trademark application" (Pet. at i) or was ordered to appear for deposition in the United States "solely because it filed a trademark application with the United States Patent and Trademark Office" (Pet. at ii).

The record shows, to the contrary, that this Petitioner's "contact" with the United States went far, far beyond a mere act of "filing" a "trademark application." In addition to the "filing of a trademark application" by Petitioner (Pet. at i), the record shows that (i) Petitioner granted broad powers of attorney

to representatives located in Arlington, Virginia; (ii) Petitioner affirmatively prosecuted the subject Application in the United States through Virginia-based representatives; (iii) Petitioner appeared in and served an Answer and other pleadings in the Opposition Case in the United States; (iv) Petitioner sought and received pre-trial discovery from Respondent in the Opposition Case; (v) Petitioner filed multiple motions seeking substantive relief in the Opposition Case; and (vi) Petitioner extensively cross-examined Respondent's witnesses during the trial of the Opposition Case which opened February 14, 2006, and was suspended when Petitioner refused to appear for deposition.

Petitioner's aggressive litigation tactics are reflected in a ten-page Order of the TTAB issued August 7, 2006, disposing of various groundless motions that Petitioner filed in March 2006. *See Virgin Enters. Ltd. v. Rosenruist-Gestao E Servicos Sociedade Unipessoal LDA*, No. 91161535 (T.T.A.B. Aug. 7, 2006) (the "August 2006 Order"). A copy of the August 2006 Order is attached as an Appendix to this Brief in Opposition. It is very telling that the Petition makes no reference to the August 2006 Order.

In its August 2006 Order, the TTAB (i) denied Petitioner's renewed motion to re-open discovery in the Opposition Case and to compel further discovery from Respondent (Resp. App. at 2a); (ii) denied Petitioner's motion to strike the testimonial deposition of Respondent's witness Neil Hobbs (*id.* at 3a-5a); (iii) denied Petitioner's motion for sanctions with respect to the testimonial deposition of VEL witness Kathryn Mollica (*id.* at 5a-7a); and (iv) over Peti-

tioner's opposition, granted Respondent's motion for suspension of proceedings in the Opposition Case so as to afford Respondent an opportunity to seek compelled trial testimony from Petitioner under 35 U.S.C. § 24 (*id.* at 7a-10a).

In sum, the "questions" identified in the Petition are not, in fact, "presented" by this case, because they are addressed to a factual scenario that is not presented by this case and is exceedingly unlikely to be presented by any future case. As a litigant and party to the Opposition Case, this Petitioner has established numerous, purposeful, and extensive contacts with the United States, spanning a period of years, over and above the mere "filing of a trademark application" (Pet. at i) back in December 2002.

III. THE QUESTIONS "PRESENTED" ARE PECULIAR TO THIS HIGHLY UNUSUAL CASE.

Passing over the false premises of the questions identified in the Petition and the Petitioner's lack of standing to raise them, those questions at most concern the correctness of the Fourth Circuit's application of well-settled legal principles to the particular, and highly unusual, circumstances of this particular Petitioner in this particular case. The Court does not sit to review such alleged errors. *See* Sup. Ct. R. 10 ("A petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law.").

The language of current 35 U.S.C. § 24 dates back to at least Section 44 of the Act of July 8, 1870,

ch. 230, 16 Stat. 198, 204 (repealed 1952). Yet the Petitioner concedes that questions purportedly "presented" by the Petition are ones "of apparent first impression." Pet. at 17. The Court can reasonably wonder why, between 1870 and 2006, no court was ever asked to hold that a party to a contested opposition case could properly refuse to appear and be cross-examined with respect to the purported factual basis of its own claim in the case.

If the questions purportedly "presented" in the Petition are ones "of apparent first impression" (Pet. at 17) despite the applicable statute's 130 years of existence, there is a ready explanation: the Petitioner's statutory and constitutional arguments are so unusual and meritless that no prior litigant has ever thought to raise them.

IV. THE DECISION BELOW DOES NOT CONFLICT WITH THAT OF ANY OTHER CIRCUIT.

Petitioner's assertion that the decision below purportedly conflicts with decisions of other circuits (Pet. at 9-10) is unsupported and erroneous. The cases cited by Petitioner all involved whether 35 U.S.C. § 24 authorized *discovery* in a patent "interference" proceeding that then-applicable PTO rules *disallowed* to the "junior party" seeking the discovery. Those decisions have no bearing on the Fourth Circuit's decision here.

In contrast with the cited cases, the Respondent here sought *trial testimony* from the Petitioner that applicable PTO rules expressly *permitted*. *See* 37 C.F.R. §§ 2.116 and 2.123(a). Respondent argued

in the district court, not that PTO rules *disallowed* the trial testimony that Respondent sought from Petitioner, but rather that Respondent should be forced to seek *permitted* trial testimony from Petitioner by means of the costly, cumbersome, and uncertain mechanism of international letters rogatory addressed to some unnamed Portuguese legal authority. The Fourth Circuit was right to reject this argument. *See Societe Nationale Industrielle Aerospatiale v. United States Dist. Court for the S. Dist. of Iowa*, 482 U.S. 522, 539-40 (1987) (holding that the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters "did not deprive the District Court of the jurisdiction it otherwise possessed to order a foreign national party before it to produce evidence physically located within a signature nation").

35 U.S.C. § 24 exists precisely to facilitate the taking of testimony that PTO rules permit, as here. In this very case, the TTAB was made aware of Respondent's subpoena of Petitioner; yet far from stating or suggesting that Respondent's invocation of 35 U.S.C. § 24 was improper or inconsistent with PTO rules, the TTAB stayed proceedings in the Opposition Case so as to permit Respondent to seek compelled trial testimony from Petitioner. *See* August 2006 Order attached as an Appendix to this Brief in Opposition, at 7a-10a.

V. THE DECISION BELOW IS CLEARLY CORRECT.

As it did below, the Petitioner urges a series of wholly frivolous arguments for why, as an alien corporation, this Petitioner supposedly was privileged

to ignore the subpoena at issue in this case. Even assuming that the Court were inclined to involve itself in a trial subpoena enforcement dispute having no significance beyond the particular parties and circumstances of this case, the decision below is clearly correct and would not justify this Court's review even on that basis.

Petitioner's assertion that 28 U.S.C. § 1783 has something to do with this case (Pet. at 3-4, 15-16) remains a total mystery. 28 U.S.C. § 1783 authorizes United States courts to issue subpoenas requiring the appearance of "a national or resident of the United States who is in a foreign country." Here, the Petitioner is an alien, not a United States national, and the subpoena in question was served on Petitioner in the United States, not "in a foreign country." The subpoena at issue in this case was not issued on the basis of 28 U.S.C. § 1783. The Petitioner's reliance on 28 U.S.C. § 1783 is so frivolous that the Fourth Circuit did not even mention it in the decision below.

Equally frivolous is Petitioner's assertion that the Fourth Circuit decision in this case somehow "intrudes upon the interest of other nations" (Pet. at 12-14). Contrary to Petitioner's suggestion, any person or party served with a subpoena under 35 U.S.C. § 24 is entitled to seek relief from the subpoena on the grounds that it imposes an "undue burden" on the subpoenaed person or party. Fed. R. Civ. P. 45(c)(3)(A)(iv). Petitioner was free at all times to seek relief from the literal command of the subpoena under Rule 45(c)(3)(A), and yet it did not do so. The reason for this is apparent: a person objecting to the

location of a deposition must generally identify an alternative or less burdensome location (*see* p 9 & note 4 *supra*). Here, the Petitioner's manifest objective was to suppress evidence, not to provide it in a more convenient location.

Petitioner's assertion (Pet. at 16-17) that Respondent was required to proceed under the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (the "Hague Convention") has absolutely no basis in the applicable rules of the PTO (*see* 37 C.F.R. § 1.123)[5] and is directly contrary to this Court's precedents. *See Societe Nationale Industrielle*, 482 U.S. at 539-40 (holding that the Hague Convention "did not deprive the District Court of the jurisdiction it otherwise possessed to order a foreign national party before it to produce evidence physically located within a signature nation"). As the Fourth Circuit correctly observed in this case, "[f]oreign corporations that are subject to the personal jurisdiction of a district court can be

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[5] As it did below, Petitioner falsely characterizes as "rules" of the PTO (Pet. at 9) the contents of a practice manual (the "TBMP") that are expressly not "rules" and do not even purport to provide any authoritative interpretative guidance with regard to 35 U.S.C. § 24 or any other statute, as the Fourth Circuit correctly held (*see* Pet. App. at 22a-23a). The cited manual furthermore says nothing about the scope of a district court's authority to compel an alien trademark applicant to appear for deposition pursuant to Federal Rule of Civil Procedure 30(b)(6). The actual "rules" of the PTO relating to the taking of trial testimony, found in 37 C.F.R. § 2.123, nowhere state or even suggest that a recalcitrant party cannot be subpoenaed to appear and give trial testimony under Federal Rule of Civil Procedure 30(b)(6). The Fourth Circuit correctly so held in this case. See Pet. App. at 23a-24a.

and often are required to produce officers, directors, or managing agents – regardless of where such witnesses personally reside – in the United States for a Rule 30(b)(6) deposition." Pet. App. 17a-18a.

When this Petitioner chose to file and prosecute an application for issuance of a United States trademark registration, Petitioner clearly knew and understood that it was claiming important substantive rights under United States law, to which certain corresponding legal obligations were attached. As a condition of being granted provisional rights under 15 U.S.C. § 1057(c), Petitioner was required to submit to the jurisdiction of United States courts and, if called upon, to comply with process served in "proceedings affecting the mark." 15 U.S.C. § 1051(e).

If Petitioner does not wish to appear for deposition upon oral examination in the Opposition Case, Petitioner need merely withdraw the Application. But it cannot have it both ways. Petitioner cannot affirmatively press a claimed right to issuance of a United States trademark registration and at the same time refuse to comply with "process in proceedings affecting the mark." 15 U.S.C. § 1051(e).

CONCLUSION

The Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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APPENDIX

APPENDIX

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 7, 2006

Opposition No. 91161535

Virgin Enterprises Limited

v.

Rosenruist - Gestao E Servicios Sociedade Unipessoal Lda

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

In accordance with the Board's order dated January 9, 2006, testimony dates were reset with rebuttal testimony to close on June 28, 2006. According to the prosecution record, both parties have taken and submitted evidence during their main testimony periods as assigned.

Several motions are now pending. The Board presumes the parties' familiarity with the matters to be considered and does not repeat all arguments made by each party.

Appendix

Applicant's motion for reconsideration

Applicant's fully-briefed motion, filed March 15, 2006, for reconsideration of the Board's order dated March 2, 2006, denying as untimely applicant's motion to compel (filed February 10, 2006), is denied. Applicant has not pointed out any error the Board may have made in considering the matter, based on the evidence of record and the prevailing legal authorities before the Board at the time the motion was originally considered. *See* TBMP §§518 and 523.03 (2d ed. rev. 2004). *See also* Trademark Rules 2.120(e) and 2.127(b). *Cf.* TBMP §528.02 (2d ed. rev. 2004); and Trademark Rule 2.127(e)(1). *See also* Trademark Rule 2.196; and 63 Fed. Reg. 48088 (1998). The Board fully explained the difference between Trademark Rule 2.120 and Trademark Rule 2.127(e)(1), including that the Board exercised its discretion, as permitted under Rule 2.127(e)(1), in considering opposer's April 18, 2005 motion for summary judgment, which was untimely. Any perceived agreement between the parties of the timeliness of either opposer's April 18, 2005 summary judgment motion or applicant's February 10, 2006 motion to compel is immaterial to the Board's determinations that both motions were, in fact, untimely. The Board notes again that it informed the parties in its August 18, 2005 summary judgment decision that first testimony period had opened and any prospective motions to compel would be considered untimely. Thus, the Board's March 2, 2006 determination that applicant's motion for summary judgment is untimely was hardly a surprise to applicant.

Appendix

Applicant's objections to opposer's amended notice of deposition and motion to strike the testimonial deposition of Neil Hobbs (taken March 15, 2006)

Opposer served a notice of deposition on March 3, 2006, such deposition to take place March 15, 2006 at 2:00 p.m. On March 14, 2006, opposer served an amended notice of opposition to correct its oversight in not indicating the matters on which the witness was to be deposed. Applicant notes that the amended notice of opposition was sent to its counsel's Virginia address despite the fact that its counsel was in New York attending a different testimonial deposition noticed by opposer. Applicant objects to the amended notice of deposition as untimely, arguing that the notice was not reasonable. Applicant also moves to strike the deposition arguing that the original notice was not facially adequate because it did not identify the name and address of the witness or provide a general description sufficient to identify the witness or provide a description with reasonable particularity of the matters upon which examination is requested. Applicant contends that it was under no obligation to notify opposer of the deficiency of the original notice of deposition but did so with its first set of objections.

In response, opposer contends that applicant had the original notice of deposition for twelve days; that applicant did not raise any concern about the notice until late in the afternoon (4:00 p.m.) of March 14th when applicant's counsel served written objections; that applicant made no timely objection to the sufficiency of

the notice; that opposer immediately served an amended notice to cure the defect in the notice pointed out by applicant in it written objections; that applicant's counsel attended the deposition, where he declined to cross examine the witness and repeated applicant's objections to the deposition;[1] and that applicant has rejected opposer's offers to permit further cross-examination during an extended testimony period. Opposer notes that direct examination of the witness lasted approximately ten minutes and was limited to two points.

All errors and irregularities in the notice for taking a deposition are waived unless written objection is promptly served upon the party giving the notice. Fed. R. Civ. P. 32(d) (1). In this case, the parties do not disagree that the face of the original notice of deposition, served March 3, 2006, was deficient. The Board finds, however, that applicant's objections, served eleven days later, on the late afternoon of the day before the deposition, were not made promptly. Applicant has provided no reasonable explanation why the objections were not made earlier, except that it was "under no obligation" to do so. However, by not doing so earlier, applicant waived its right to object. After all, insofar as the notice was defective on its face, had applicant served prompt objections, opposer could have cured the defect

1. In this regard, opposer points out that applicant's counsel was in New York for several days to attend five testimonial depositions noticed by opposer to take place between March 8-15, 2006.

sooner. As it is, opposer took action to cure the defect immediately upon being notified. Moreover, applicant's counsel was already in New York for testimonial deposition in this case; and the matters upon which the witness testified do not appear to have been complicated.

Accordingly, applicant's motion to strike the deposition based on the adequacy of the original notice is denied; and, considering the circumstances presented, applicant's objections to the amended notice on the ground of timeliness are overruled.

Applicant's motion for sanctions

On March 22, 2006, applicant moved for sanctions with respect to the March 13th deposition of Kathryn Mollica. According to applicant, the deposition ended after cross examination and opposer's attorney left the room to escort Ms. Mollica out of the office; and about ten minutes later, while applicant's attorney was packing up, one of opposer's attorneys returned to advise applicant's attorney that the witness was being called back for additional questioning. Applicant argues that, prior to resumption of testimony, it objected to any off-the-record, private consultation between the witness and opposer's counsel; that in response to an inquiry from applicant's counsel about what she had discussed with opposer's counsel, the witness responded, "I said something to him that I wanted to get on the record"; and that the re-direct examination was improper insofar as it resulted from consultation between the witness and

her attorney after conclusion of the deposition. Applicant brings to the Board's attention several cases that applicant believes stand for the proposition that a witness and his or her attorney may not confer during the course of a deposition. As a sanction, applicant seeks to strike the entire deposition of Ms. Mollica.

According to opposer, after cross examination, a break was taken in the deposition during which opposer's counsel escorted the witness to the bathroom and briefly conferred to determine whether re-direct examination was appropriate because the witness forgot to mention "media impressions" (media advertising) in her direct testimony. Opposer indicates that applicant's counsel was permitted to inquire into the purported "conference" between Ms. Mollica and opposer's counsel; that no conduct occurred that is improper; and that, certainly, no conduct occurred so as to warrant striking the entire testimonial deposition. Opposer argues that the cases referenced by applicant stand for the proposition that a witness may not confer with his or her attorney *during* (emphasis added) cross examination, but do not disapprove of such conferring after an adversary has completed its cross examination and prior to re-direct examination.

While the witness states that she spoke briefly to her attorney about a matter she " . . . wanted to get on the record, which was about our media impression," she also indicates that she then went to the bathroom before re-direct examination began. It does not appear that there was any coaching or change of testimony, or that

the deponent's credibility is impaired as a result of the re-direct examination. Nor does there appear to be measurable prejudice to applicant inasmuch as applicant's attorney was able to question the witness as to the content of any conversation she had with her attorney during the "break," which both parties indicate was short. Applicant further was able to conduct re-cross-examination. The mere fact that the witness was recalled does not demonstrate improper or sanctionable conduct.

Accordingly, applicant's motion for sanctions is denied.

Opposer's motions to extend testimony and to suspend proceedings

Opposer's first testimony period closed on March 15, 2006. On March 14th, opposer moved to extend testimony on the basis that an unresolved district court matter was pending with respect to a subpoena for a testimonial deposition of applicant's corporate witness. According to opposer, the subpoena was issued on January 31, 2006; applicant moved to quash, which the district court, on March 2, 2006, denied; as a consequence, a second trial deposition subpoena was issued on February 27, 2006; and applicant, filing objections to the subpoena, otherwise failed to comply therewith.

In response, applicant contends that the denial of the motion to quash was nominal insofar as the court ordered, and clarified in a hearing conducted March 24,

2006, a witness for "somebody who is a resident or living in this district" and did not make a ruling that ". . . compels somebody . . . who lives in a foreign country to come." Applicant, a foreign entity, argues that it has no witness residing or living in the relevant judicial district, and that it so informed both opposer and the court prior to the date on which opposer sought the deposition in question.

The Board notes in passing that its January 9, 2006 order addressed the Board's written policy concerning an adverse party whose trial deposition is sought and who resides in a foreign country.

On May 12, 2006, opposer again sought an extension of testimony, informing the Board that the matter concerning the sought trial deposition remains pending. This is so because opposer has appealed the April 6, 2006 determination of the magistrate judge that the district court lacked the authority (under 35 U.S.C. §24) to compel applicant to appear for a deposition except by individuals who live or reside in the judicial district (Eastern District of Virginia) and who consent to testify on applicant's behalf. Opposer indicates that the appeal now is pending before the Fourth Circuit.

In response, applicant contends that there is no reason to extend dates because it is unlikely that the Fourth Circuit will overrule long-standing precedent and force applicant's corporate witness to involuntarily appear in the Eastern District of Virginia when the witness lives and resides in Portugal.

On August 3, 2006, opposer moved to suspend proceedings pending the decision of the Fourth Circuit on this matter.

Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceeding before the Board may be suspended until final determination of the civil matter (which includes exhaustion of appeals taken). To the extent that a case in Federal court involves issues in common with those in the proceeding before the Board, the decision of the court is often binding on the Board, while the decision of the Board is not binding upon the court. TBMP Section 510.02 (2d ed. June 2003). It is only necessary that the determination of issues presented to the court may have a bearing on the issues presented to the Board, and judicial economy lies in the suspension of the Board proceeding.

In this case, the determination by the Fourth Circuit of whether opposer can take the trial deposition of applicant's witness may have an affect on the administration of this opposition. Accordingly, opposer's motion to suspend proceedings is granted, and proceedings are suspended pending final disposition of the civil matter between the parties concerning the enforcement of opposer's subpoena.

Within twenty days after the final determination of this matter, the parties should notify the Board so that this case may be resumed. If opposer does not prevail,

there does appear to be any reason to extend opposer's main testimony period because it has submitted other evidence and because the sole reason it seeks to extend the dates is to accommodate the trial deposition of applicant's corporate witness. In regard to the schedule, applicant also submitted evidence during its scheduled testimony period and has not asked for an extension thereof. Thus, upon resumption, depending on the final determination of the civil matter, it may be that only rebuttal testimony is reset in this opposition. Consequently, full consideration of opposer's motions to extend testimony is deferred.

During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

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No. 07-1214

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IN THE

Supreme Court of the United States

ROSENRUIST-GESTAO E SERVICOS LDA,
formerly known as ROSENRUIST-GESTAO E SERVICOS SOCIEDADE UNIPESSOAL LDA,

Petitioner,

v.

VIRGIN ENTERPRISES LIMITED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

Petitioner's corporate disclosure statement was set forth at page *iii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

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INTRODUCTION

Petitioner Rosenruist-Gestao E Servicos LDA's petition raises an important federal question, the outcome of which will impact the foreign relations of the United States, especially as related to the worldwide examination of patent and trademark applications. The petition notes the different interpretations among the circuit courts regarding the scope of 35 U.S.C. § 24 and suggestions in these decisions that these conflicts deserve the attention of this Court.

Put bluntly, respondent Virgin Enterprises Limited's ("VEL") Brief in Opposition ducks the merits of the important federal questions involved in this appeal, attempting instead to selectively comment on non-germane portions of the proceedings before the United States Patent and Trademark Office. VEL's first mention of 35 U.S.C. § 24, the central statute to be interpreted, does not occur until the bottom of page 24 of its 27 page brief. But, as stated in the dissenting opinion,

> The decision to extend the subpoena power under 35 U.S.C. § 24 to foreign companies situated similarly to Rosenruist is one that is plainly before this court, and its importance warrants full discussion.

(Pet. App. 26a).

The question presented is whether 35 U.S.C. § 24, which authorizes a district court to subpoena a witness "residing or being within such district," confers the authority to subpoena alien witnesses located in foreign countries who have no connection with the district other than an agent to receive service of process to travel to the district for deposition.

If the decision below is not reversed, the ultimate result is that 35 U.S.C. § 24 will have been dispositively expanded, and the contrary views of other circuits as to the limitations of the statute will be ineffective. As noted in the dissent, "[T]he majority creates a standard that is in fact a national one. . . . Indeed, for any foreign corporation without a pre-existing United States presence, the majority's decision will be controlling." (Pet. App. 26a).

I. VEL'S ARGUMENT THAT THE DECISION BELOW IS CLEARLY CORRECT IS WITHOUT MERIT AND CONTRARY TO THE RECORD

Other than engaging in a contorted procedural account of issues not germane to the questions presented, VEL identifies only three grounds for its contention that the majority opinion is correct. Nowhere in VEL's Brief in Opposition does it even mention the multi-faceted rationale for Judge Wilkinson's dissent, let alone attempt to address his analysis.

A. 28 U.S.C. § 1783 strongly supports a conclusion that 35 U.S.C. § 24 is to be read consistently with principles of comity and restraint in foreign relations.

VEL characterizes as "frivolous" Rosenruist's argument that construing the subpoena power of Section 24 to authorize compulsion of a foreign national to travel to the United States to testify is contrary to the intent of Congress. Regarding congressional intent, VEL argues that 28 U.S.C. § 1783 offers no support for a limitation on compulsory attendance of a non-resident foreign national. VEL asserts that Section 1783 refers only to a U.S. national. But this is precisely the point. Congress deliberately decided not to extend the subpoena power of a district court to include non-resident aliens.

Congress's election to limit the subpoena power was specifically stated in the legislative history of Section 1783, and it corresponds with the prior restriction imposed by this Court in *Blackmer v. United States*, 284 U.S. 421 (1932). "The purpose of the different language used with respect to noncriminal cases is to restrict still further the extraordinary subpena [sic] power in such cases." S. Rep. 88-1580, at 10 (1964), *reprinted in* 1964 U.S.C.C.A.N. 3782, 3790-91. Section 1783 embraces this Court's holding in *Blackmer*. The failure of the majority opinion to give *Blackmer* or Section 1783 any recognition does not render the statutory limitations frivolous. Rather, it emphasizes the error in disregarding this Court's clearly expressed holding and the corresponding legislative intent expressed in the 1964 amendments to Section 1783.

B. The question of whether a witness not residing or being in the district is within the subpoena power of 35 U.S.C. § 24 is independent of a claim of unreasonable burden that may be asserted by a witness who is within the power of the district court.

VEL's second reason for asserting that the decision below is correct is that a subpoenaed entity can seek relief on grounds of undue burden. This argument merely sidesteps the fundamental issue, which is that 35 U.S.C. § 24, by its very terms, is limited to "a witness residing or being within such district." The issue is one of lack of authorization under the terms of Section 24 and the conflict with principles articulated in *Blackmer* and in 28 U.S.C. § 1783. By pointing to Federal Rule of Civil Procedure 45, VEL once again attempts to interject non-determinative procedural rules in an effort to avoid the significant policy issues presented in this appeal.

C. The USPTO recognizes multiple alternative means for obtaining discovery from foreign applicants and Rosenruist has never argued that resort to the Hague Convention is the sole means available for obtaining discovery.

The third of the grounds alleged by VEL to support the correctness of the decision below is based upon a gross mischaracterization of Rosenruist's position and the nature of the appealed district court order from which the appeal originated. VEL's Brief in Opposition page 26, citing to *Societe Nationale Industrielle Aerospaciale v. United States Dist. Court for the S. Dist. Of Iowa*, 482 U.S. 522 (1987), states that Rosenruist

asserted in its Petition at page 16-17 that VEL "was required" to proceed under the Hague Convention on taking Evidence Abroad in Civil Or Commercial Matters. (Opp. 26). Rosenruist is well aware of *Societe Nationale* and never made any such assertion either in its Petition herein or in the proceedings below.

What Rosenruist did say is that the TTAB Manual of Procedure expressly recognizes a limitation on the ability to require non-resident aliens to appear for deposition in the United States. (Pet. 16, 17). Accordingly, the TTAB Manual of Procedure lists several alternative methods of obtaining testimony: deposition on written questions; letters rogatory; and requests made pursuant to the Hague Convention. TBMP §§ 703.01(f) and 703.02.

Rosenruist has never argued that the Hague Convention deprives the district court of jurisdiction it otherwise possesses. The fallacy underlying VEL's erroneous statement of Rosenruist's argument, is that the district court never "otherwise possessed" jurisdiction over Rosenruist for purposes of commanding Rosenruist to appear and testify because 35 U.S.C. § 24 limits this subpoena power to witnesses "residing or being with the district," and Rosenruist has no contact with the Eastern District of Virginia other than the designation of an agent for the limited power of accepting service of process.[1] This is insufficient to confer general or specific jurisdiction. (dissent, Pet. App. 31a).

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1. 15 U.S.C. § 1051(e) does not purport to require designation of a general agent. The narrow requirement of Section 1051(e) is limited to acceptance of service – i.e., to ensure notice to an affected party, but not to act generally on behalf of the party.

II. OTHER THAN ABBREVIATED ARGUMENT THAT THE FOURTH CIRCUIT DECISION BELOW WAS CORRECT, THE REMAINDER OF VEL'S OPPOSITION CONSISTS OF FOUR ADDITIONAL CONTENTIONS, NONE OF WHICH HAVE ANY MERIT

A. No cross-appeal was necessary.

VEL's first contention is that Rosenruist was obliged to file a cross-appeal in order to present the questions raised herein. The error of this argument is immediately apparent as set forth in the dissenting opinion, discussion appearing at Pet. App. 43a. As noted in that dissent, the judgment of the district court was that Rosenruist could not be compelled to appear at a deposition in the Eastern District of Virginia because of the requirement of the "witness residing or being within [the] district" language of 35 U.S.C. § 24. The majority in the Fourth Circuit opinion ruled that it could.

In its appeal to the Fourth Circuit, VEL itself described the issue as follows: "This case concerns the scope of the District Court's subpoena power under 35 U.S.C. § 24." (Fourth Circuit Brief for Appellant at 3). Similarly, Rosenruist stated the issue as: "Whether the District Court correctly denied VEL's motion to compel, subsequent to the Court's satisfying itself that Rosenruist had no 'witness' under 35 U.S.C. § 24 residing or being in the district." (Fourth Circuit Brief for Appellee at 4). The dissent in the Fourth Circuit opinion noted:

> Rosenruist is seeking to affirm the judgment declining to enforce the subpoena, not to

> modify any part of it, and a party seeking affirmance of a judgment need not lodge a cross-appeal to have that affirmance rest on an alternate ground. In view of the fact that this is a single judgment, and Rosenruist prevailed on that judgment, one cannot possibly saddle Rosenruist –as the majority has – with the obligation to file a cross appeal.

(Pet. App. 34a).[2]

B. The Questions Presented concern the fundamental and ongoing issues in this action.

VEL's next contention is that the questions presented in this petition are not the questions presented by this case. This argument is based upon a distorted and immaterial recitation of selected proceedings before the USPTO, none of which decide the scope of 35 U.S.C. § 24. Nor do the PTO proceedings resolve different interpretations as to the scope of § 24 among the circuits.

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2. VEL's analogy to the facts of *Northwest Airlines, Inc. v. County of Kent*, 510 U.S. 355 (1994), is inapposite because Rosenruist does not challenge the district court's authority "to do anything at all," as VEL alleges, but rather challenges only the district court's authority to compel the appearance and testimony of foreign alien witnesses with no connection to the district other than a contested trademark application before the USPTO. This challenge is based on the "witness residing or being within" language of 35 U.S.C. § 24, which only is implicated in compelling an appearance in the district and not, for example, in compelling deposition upon written questions.

C. No court has ever interpreted 35 U.S.C. § 24 to authorize compulsory attendance in the Eastern District of Virginia of a foreign entity which has no presence in the District.

VEL's third contention is that the questions presented herein are peculiar to what it calls a highly unusual case. VEL argues that the Court should not resolve an issue of apparent first impression because for 130 years no prior litigant has ever thought to raise them.[3] VEL would have been well advised to read the opening (and unchallenged) first sentence of the dissent:

> *In a first for any federal court*, my colleagues hold that a foreign company that has no United States employees, locations, or business activities must produce a designee to testify at a deposition in the Eastern District of Virginia so long as it has applied for trademark registration with a government office located there.

(Pet. App. 25a (emphasis added)).

It is not that the issues presented herein are so meritless that no prior litigant has ever thought to raise them as VEL urges, but, rather, that no party to a PTO proceeding previously has sought to over-expand the scope of Section 24 in a manner hostile to established principles of comity and international relationships long observed by both Congress and this Court.

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3. Although this petition does present issues of first impression, Section 24 was enacted in 1952 with the Patent Act and has not existed for 130 years.

D. There is a conflict among the circuits in their determination of the scope of 35 U.S.C. § 24.

In the last of its preliminary contentions prior to finally addressing whether the decision below was correct, VEL asserts that the decision below does not conflict with the decision of any other court because it permits only what the PTO rules permit.

VEL acknowledges that Section 24 exists to facilitate the taking of testimony *that PTO Rules permit* and asserts that the testimonial deposition it seeks is expressly permitted by the PTO rules. (Opp. 24). VEL is mistaken. The TTAB Manual of Procedure, which constitutes the agency's interpretation as to the scope and applicability of its rules, plainly distinguishes between the testimony of a witness *residing in the United States*, TBMP § 703.01(f)(2), and an unwilling witness in a foreign country, TBMP § 703.01(f)(3). For a witness residing in the United States there is specific reference to 35 U.S.C. § 24 as the available method of securing testimony. By contrast, Section 703.01(f)(3) does not refer to the use of Section 24, but does designate two alternate means of securing testimony in addition to the availability of depositions upon written questions as authorized in Section 703.02 and the PTO rules noted therein.

VEL was unable to cite any PTO provision authorizing the subpoena of a foreign witness. Also, VEL failed to acknowledge the divergent views of Section 24 expressed by the circuits. In *Sheehan v. Doyle*, 529 F.2d 38, 40 (1st Cir. 1976), the First Circuit referred specifically to the regrettable uncertainty created by the split in the circuits and suggested that the Supreme Court may think it desirable to terminate the divergent interpretations that now exist. It is difficult to ascertain the basis for VEL's assertion that there is no such conflict.

CONCLUSION

VEI's opposition fails to articulate any meritous reason why this Court should not resolve the conflicts expressed by the circuit courts as to the scope of Section 24. The majority opinion of the Fourth Circuit is inconsistent with the reading of the statute by the First, Third, and Fifth Circuits (*see* Pet. 9-10) and would impose a national standard of compulsory attendance in the United States for all foreign applicants for a United States patent or trademark.

The dissonance with the worldwide functioning of the patent and trademark system is apparent, as is the likely consequence that foreign patent and trademarks offices will impose severely unreasonable demands upon United States applicants for foreign patent or trademark prosecution.

The majority's interpretation of 35 U.S.C. § 24 conflicts with statutory intent, existing precedent, and principles of restraint and comity long recognized by this Court. The policy implications as well as the conflicting views of the circuits strongly support grant of this petition.

Respectfully submitted,

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